Supreme Court, U.S.

06136 2007

No. OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

AKEVA L.L.C.,

Petitioner,

v.

ADIDAS AMERICA, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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April 12, 2007

QUESTIONS PRESENTED

1. Whether the Federal Circuit contradicts core principles of patent law and its own settled precedent by holding that, absent a clear disavowal of the ordinary meaning of a patent claim term, a different meaning may be ascribed to such a term based upon equivocal language from the patent specification.

2. Whether the Federal Circuit, purporting to apply its own de novo standard of review mandated by *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998), may defer to a district court if the Federal Circuit simply concludes that some evidence supports the district court's analysis and conclusions.

3. Whether a court construing the meaning of a patent claim may categorically refuse to consider highly probative claim differentiation in ancestral patents based on immaterial differences in the patent specifications.

RULE 29.6 STATEMENT

Petitioner Akeva L.L.C. states that it is not a publicly traded company, that it has no parent corporation, and that no publicly held company owns 10% or more of its stock.

PARTIES TO THE PROCEEDING

Pursuant to Rule 14.1(b), the following list identifies all of the parties appearing here and before the United States Court of Appeals for the Federal Circuit in this matter:

Akeva L.L.C. (Petitioner/Appellant)

Adidas America, Inc. (Respondent/Appellee)

Adidas-Salomon AG (Appellee)

TABLE OF CONTENTS

QUESTIONS PRESENTED i

RULE 29.6 STATEMENT ii

PARTIES TO THE PROCEEDING iii

TABLE OF AUTHORITIES vi

OPINIONS BELOW 1

JURISDICTION 1

STATUTORY PROVISION AT ISSUE 1

STATEMENT OF THE CASE 2

A. Factual Background 5

B. District Court Proceedings 7

C. Proceedings Before the Federal Circuit 10

REASONS FOR GRANTING THE PETITION 13

I. CERTIORARI SHOULD BE GRANTED TO REMEDY THE FEDERAL CIRCUIT'S CONTINUED FAILURE TO SET FORTH AN INTELLIGIBLE STANDARD FOR DISCERNING WHEN PATENT CLAIMS MAY BE READ CONTRARY TO THEIR ORDINARY MEANING 13

II. THIS COURT'S INTERVENTION IS NEEDED TO ENSURE THAT THE FEDERAL CIRCUIT ACTUALLY CONDUCTS THE CRITICAL DE NOVO CLAIM CONSTRUCTION ANALYSIS THAT IT PURPORTS TO REQUIRE 25

III. THIS COURT SHOULD RECTIFY THE FEDERAL CIRCUIT'S REFUSAL TO CONSIDER HIGHLY PROBATIVE ANCESTRAL PATENTS 28

CONCLUSION 30

Appendix A

Akeva L.L.C. v. Adidas-Salomon AG et al., No. 06-1090, 2006 U.S. App. LEXIS 28195 (Fed. Cir. Nov. 13, 2006) 1a

Appendix B

Akeva L.L.C. v. Adidas America, Inc., 385 F. Supp. 2d 559 (M.D.N.C. Aug. 2005) 10a

Appendix C

Akeva L.L.C. v. Adidas America, Inc., No. 03-CV-1207, 2005 U.S. Dist. LEXIS 11213 (M.D.N.C. May 17, 2005) 25a

Appendix D

Order Denying Rehearing and Rehearing En Banc, *Akeva L.L.C. v. Adidas-Salomon AG et al.*, No. 06-1090 (Fed. Cir. Jan. 12, 2007) 66a

Patent Appendix A

U.S. Patent No. 6,604,300 ("'300 Patent") 1a

Patent Appendix B

U.S. Patent No. 6,662,471 ("'471 Patent") 49a

TABLE OF AUTHORITIES

CASES

Akeva L.L.C. v. Mizuno Corp., 243 F. Supp. 2d 418 (M.D.N.C. 2003) 7

Akeva L.L.C. v. New Balance Athletic Shoe, Inc., No. 03-CV-1044 (M.D.N.C. filed Nov. 4, 2003) 7

Alloc, Inc. v. United States Int'l Trade Comm'n, 342 F.3d 1361 (Fed. Cir. 2003), ... 24

Amgen Inc. v. Hoechst Marion Roussel, Inc., 457 F.3d 1293, *reh'g denied*, 469 F.3d 1039 (Fed. Cir. 2006), *pet. for cert. filed*, No. 06-1291 (March 22, 2007) 25, 28

Amgen Inc. v. Hoechst Marion Roussel, Inc., 469 F.3d 1039 (Fed. Cir. 2006) (en banc) 20

Andersen Corp. v. Fiber Composites, LLC, 474 F.3d 1361 (Fed. Cir. 2007) 20

CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359 (Fed. Cir. 2002) 17

Comark Commc'ns., Inc. v. Harris Corp., 156 F.3d 1182 (Fed. Cir. 1998) 4, 15, 29

Continental Paper Bag Co. v. E. Paper Bag Co., 210 U.S. 405 (1908) 13

Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448 (Fed. Cir. 1998) 5, 25, 26, 28

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002) 22, 23

General Elec. Co. v. Wabash Appliance Corp., 304 U.S. 364 (1938) 13, 14

Golight, Inc. v. Wal-Mart Stores, Inc., 355 F.3d 1327 (Fed. Cir. 2004) 20

Goldenberg v. Cytogen, 373 F.3d 1158 (Fed. Cir. 2004) 30

Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.3d 951 (Fed. Cir. 2000) 16, 17

Hoganas AB v. Dresser Indus., Inc., 9 F.3d 948 (Fed Cir. 1993) 27

Honeywell Int'l, Inc. v. ITT Indus., 452 F.3d 1312 (Fed. Cir. 2006) 20, 21

Howe Machine v. National Needle, 34 U.S. 388 (1890) 14

Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111 (Fed. Cir. 2004) 15

Johnson Worldwide Assoc., Inc. v. Zebco Corp., 175 F.3d 985 (Fed. Cir. 1999) 17

Jonsson v. Stanley Works, 903 F.2d 812 (Fed. Cir. 1990) 29

Key Pharms. v. Hercon Labs. Corp., 161 F.3d 696 (Fed. Cir. 1998) 26

Keystone Bridge Co. v. Phoenix Iron Co., 95 U.S. 274 (1877) 14

Liebel-Flarsheim v. Medrad, Inc., 358 F.3d 898 (Fed. Cir. 2004) 16, 17, 20, 29

LNP Eng'g Plastics v. Miller Waste Mills, 275 F.3d 1347 (Fed. Cir. 2001) 26

Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) 2, 7, 8, 13, 14, 28

McCarty v. Lehigh Valley Pub. R.R. Co., 160 U.S. 110 (1895) 13

Microsoft Corp. v. Multi-Tech Sys., Inc., 357 F.3d 1340 (Fed. Cir. 2004) 29

Minnesota Mining and Mfg. Co. v. Chemque, Inc., 303 F.3d 1294 (Fed. Cir. 2002) 26

nCube Corp. v. Seachange Int'l, Inc., 436 F.3d 1317 (Fed. Cir. 2006) 21

NTP, Inc. v. Research in Motion, Ltd., 418 F.3d 1282 (Fed. Cir. 2005) 21, 29

Nystrom v. Trex Co., Inc., 424 F.3d 1136 (Fed. Cir. 2005) 21

Omega Eng'g, Inc. v. Raytek Corp., 334 F.3d 1314 (Fed. Cir. 2003) 17

Phillips v. AWH Corp., 376 F.3d 1382 (Fed. Cir. 2004) (en banc) 17

Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc) 1, 3, 18, 19, 20, 21

SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337 (Fed. Cir. 2001) 11, 15, 17

Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313 (Fed. Cir. 2002) 16, 17, 24

Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002) 16

United States v. Adams, 383 U.S. 39 (1966) 14

University of Rochester v. G.D. Searle & Co., 358 F.3d 916 (Fed. Cir. 2004) 13

Utah Med. Prods. v. Graphic Controls, 350 F.3d 1376 (Fed. Cir. 2003) 26

Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576 (Fed. Cir. 1996) 16

White v. Dunbar, 119 U.S. 47 (1886) 14

STATUTES AND REGULATIONS

28 U.S.C. § 1254(1) 1

28 U.S.C. § 1295(a) 15

35 U.S.C. § 112 ..... 1, 2, 6, 13

35 U.S.C. § 120 7

35 U.S.C. § 154(a)(2) 7

37 C.F.R. § 1.53(b)(2) 7

RULES

Fed. R. Evid. 201(d) 27

S. Ct. R. 10(c) 25

Fed. Cir. R. 32.1(c) 10

Fed. Cir. R. 47.6 (2006) 10

MISCELLANEOUS

Holly L. Bonar, *Is Something Amiss? A Commentary on the Aftermath of* Phillips v. AWH Corp., 88 J. Pat. & Trademark Off. Soc'y 513 (2006) 18, 21

William H. Burgess, *Comment: Simplicity at the Cost of Clarity: Appellate Review of Claim Construction and the Failed Promise of* Cybor, 153 U. Pa. L. Rev. 763 (2004) 26

DONALD S. CHISUM, CHISUM ON PATENTS (2005 & 2007 Supp.) 16, 21

Crissa A. Cook, *Comment: Constructive Criticism:* Phillips v. AWH Corp. *and the Continuing Ambiguity of Patent Claim Construction Principles*, 55 Kan. L. Rev. 225 (2006) 18, 21

ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT (6th ed. 2004 Supp.) 17

R. CARL MOY, MOY'S WALKER ON PATENTS (2006) .. 16, 21

David Sanker, *Note:* Phillips v. AWH Corp.*: No Miracles in Claim Construction*, 21 Berkeley Tech. L.J. 101, 114 (2006) 19, 24

U.S. Opp., *Alloc, Inc. v. United States Int'l Trade Comm'n*, No. 03-1187 (2004) 24

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is unreported and is reprinted in the Appendix to the Petition ("Pet. App.") at 1a-9a. The Federal Circuit denied Petitioner Akeva L.L.C.'s ("Akeva's") petition for rehearing or rehearing en banc in an unpublished order. *Id.* at 66a-67a.

The District Court's claim construction decision is unreported and is reprinted at Pet. App. 25a-65a. The District Court's order concerning the impact of *Phillips v. AWH Corp.*, 415 F.3d 1303 (2005) (en banc), and denying Akeva's motion for reconsideration, is reported at 385 F. Supp. 2d 559 (M.D.N.C. 2005), and is reprinted at Pet. App. 10a-24a.

JURISDICTION

The Federal Circuit issued its decision on November 13, 2006. Pet. App. 1a. Petitioner's petition for rehearing or rehearing en banc was considered by the Federal Circuit and denied on January 12, 2007. *Id.* at 67a. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STATUTORY PROVISION AT ISSUE

In relevant part, 35 U.S.C. § 112 provides:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

STATEMENT OF THE CASE

This case perfectly exemplifies the Federal Circuit's confounding and unpredictable approach to patent claim construction – an approach that cries out for this Court's intervention. In the decision below, the Federal Circuit disregarded the ordinary meaning of a straightforward claim term, which had been expressly adopted by the United States Patent and Trademark Office ("PTO"), in order to reach a preferred result of denying the inventor the full breadth of his patented claims. Contradicting years of its own precedent, the Federal Circuit cursorily affirmed the district court's claim construction ruling without establishing that the patent specification indicated a clear disavowal of the ordinary meaning of the claim term at issue and without conducting a true de novo analysis.[1]

In the decision below, the Federal Circuit refused to honor Petitioner Akeva's rights in a patented "flexible member" technology for athletic shoes, which provides improved cushioning and spring.[2] Despite clear language in

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[1] Consistent with this Court's practice and common usage, *see Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 378-79 (1996), the non-claim portion of the patent specification will be referred to as the "specification," although 35 U.S.C. § 112 refers to the non-claim portion as the "written description."

[2] For purposes of this Petition, "flexible member" is an inclusive term referring to the enhanced spring aspect of Petitioner's

Akeva's patent claims covering flexible members in *all* shoes – regardless of whether the rear soles are conventional, detachable, or rotatable – the Federal Circuit limited Akeva's patent protection to flexible members in the virtually nonexistent set of shoes with detachable or rotatable rear soles. The deficiency of the Federal Circuit's outcome-oriented approach is laid bare by, among other things, the fact that to reach its chosen outcome, the Court divergently interpreted, in two separate but closely linked patents, the *same* claim term drafted by the *same* inventor in the *same* field of invention – in neither case giving the term its ordinary meaning. Specifically, the Court determined that "secured" did not simply mean "attached." Rather, for one of the patents at issue, the Federal Circuit interpreted "secured" to mean "detachably secured." Pet. App. 5a. And for the other patent – in order to circumvent the patent's clear statement that it applied to shoes with "permanently attached rear soles" as well as detachable ones – the Federal Circuit interpreted "secured" to mean "secured to the shoe, but not permanently fixed." *Id.* at 8a-9a. This tortured reasoning and result belie an ends-oriented approach that ignores basic claim construction principles.

The Federal Circuit's disarray concerning whether, if ever, it is appropriate to read limitations into the ordinary meaning of claim language is nothing new. What is new, however, is clear proof that the Federal Circuit is not able to resolve this problem on its own. In its en banc ruling in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), the Federal Circuit purported to bring clarity to this issue. But that decision only made matters worse, as made clear by

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invention. One patent at issue covers a "flexible plate," whereas the other covers a flexible, U-shaped member.

practice since *Phillips*, including the decision below. Not only did *Phillips* confusingly reaffirm starkly conflicting strands of its own precedent – explaining why nearly all of the Federal Circuit judges were able to concur in the Court's articulation of the basic principles of claim construction – but *Phillips* also has now been read by various Federal Circuit panels, including the panel below, as having implicitly overruled the longstanding principle that a "heavy presumption" attaches to a claim term's ordinary meaning. to one skilled in the art. Thus, since *Phillips*, the Federal Circuit's claim construction decisions have been anything but predictable: some, citing *Phillips*, continue to accord a patent term's ordinary meaning the utmost weight, whereas others invoke *Phillips* to justify casually importing limitations from the patent specification into otherwise clear claim language. Because *Phillips* provides something for everyone, it has ushered in a new era of incoherence and unpredictability in the Federal Circuit.

Without a heavy presumption that claim terms have their ordinary meaning, there can be no coherent, fair, or predictable way for courts to patrol the "fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification." *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998). Although this Court has repeatedly recognized the importance of maintaining this line, it has not yet intervened, allowing the Federal Circuit the opportunity to resolve this important and recurring issue on its own. Because the Federal Circuit has now conclusively proven its inability to do so, the time for this Court's intervention has arrived. This case provides an ideal vehicle because the Federal Circuit's refusal to apply the heavy presumption of ordinary meaning of "secured" was conclusive.

The decision below suffers from two additional errors reflecting rifts within the Federal Circuit, both of which also warrant review. *First*, the Federal Circuit – as is too often the case – failed to engage in a de novo review of the District Court's claim construction, as the Federal Circuit has required since *Cybor Corp. v. FAS Technologies., Inc.*, 138 F.3d 1448 (Fed. Cir. 1998). This Court's intervention is necessary to ensure that the Federal Circuit actually applies the de novo analysis it purports to require. Otherwise, as here, the Federal Circuit is prone to affirming a lower court's decision so long as *some evidence* supports the claim construction. *Second*, this Court's review is urgently needed to ensure that courts actually do consider all intrinsic evidence relevant to claim construction, as *Phillips* purports to require. Here, the Federal Circuit ignored highly probative evidence from ancestral patents, placing itself within an intracircuit divide over the appropriate use of such evidence. Guidance from this Court is necessary.

A. Factual Background

Petitioner Akeva is a company, owned in part by inventor David Meschan, that has been assigned certain patents created by Mr. Meschan. Mr. Meschan is an avid runner who has patented several innovations for the improvement of athletic shoes over the past eleven years. Two of his patented improvements to athletic shoes are relevant here. *First*, Mr. Meschan has patented various forms of a detachable/rotatable rear shoe sole that allows customization of the sole and can extend the life and performance of the shoe. *Second*, Mr. Meschan has patented various forms of a flexible member found within the rear sole of an athletic shoe, to enhance spring and cushioning.

Although this case involves two separate patents, U.S. Patent No. 6,604,300 (the "'300 patent") and U.S. Patent No. 6,662,471 (the "'471 patent"),[3] the same claim term – "secured" – is at issue. Both the '300 and '471 patents claim certain flexible members in athletic shoes. The claims of both patents define the covered class of shoes as having an "upper" portion with "a rear sole *secured* below" the upper. Pet. App. 3a (emphasis added). Thus, the patents cover all flexible member shoes with a "secured" rear sole.

In addition to describing the claimed flexible member, each patent specification also revisits the features of previously claimed detachable/rotatable rear soles as the inventor's "best mode contemplated . . . of carrying out his invention," commonly referred to as the "preferred embodiment." 35 U.S.C. § 112. Although the specifications explain that detachable/rotatable rear soles are the preferred embodiment, they also make clear that the flexible member "need not be used only in conjunction with a detachable rear sole, *but can be used with permanently attached rear soles as well*." Patent App. 35a ('300 patent) (emphasis added). Both patent specifications discuss detachable/rotatable rear soles not only because of the "preferred embodiment" requirement of 35 U.S.C. § 112, but also because both patents were issued by the PTO as continuations of earlier patents that had claimed various forms of a detachable/rotatable rear sole, in addition to disclosing the flexible member invention claimed by the '300 and '471 patents.[4]

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[3] The patents are reprinted in a separate Patent Appendix ("Patent App.") at 1a-48a ('300 patent) and 49a-88a ('471 patent).

[4] Frequently in continuation practice, an inventor will not remove material from the specification even though the newly asserted claims pertain to only a limited portion of the specification, or, in

After filing for patents on his rear sole and flexible member technologies in the mid-1990s, Mr. Meschan created prototypes and approached several leading shoe companies to assess their interest in licensing his patented technologies. Without licensing these technologies, some companies began using Akeva's patented technologies in their commercial shoe models. Based on patents similar to those at issue here, Akeva brought patent infringement suits against two leading companies, Mizuno and New Balance. *See, e.g.*, *Akeva L.L.C. v. Mizuno Corp.*, 243 F. Supp. 2d 418 (M.D.N.C. 2003); *Akeva L.L.C. v. New Balance Athletic Shoe, Inc.*, No. 03-CV-1044 (M.D.N.C. filed Nov. 4, 2003). As in this case, both suits claimed infringement by shoes that had a flexible member but did not have detachable/rotatable rear soles. Both suits settled prior to rulings on claim construction.

B. District Court Proceedings

Like Mizuno and New Balance, Respondent Adidas subsequently brought to market new shoe models that infringed on Akeva's flexible member technology. Because the Adidas shoes were covered by Akeva's '300 and '471 patents, Akeva brought suit against Adidas for patent infringement in the Middle District of North Carolina.

In advance of trial, the District Court held a *Markman* hearing to determine the proper construction of disputed claim terms in the '300 and '471 patents. *Markman v.*

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the case of a continuation-in-part, pertain to only the newly added portion of the specification. *See* 37 C.F.R. § 1.53(b)(2). Although continuations allow an inventor to maintain an earlier priority date, *see* 35 U.S.C. § 120, they have the drawback of providing a shorter period of patent coverage, because the term of a continuation patent is based on the start date of the first patent in the series, *see* 35 U.S.C. § 154(a)(2).

Westview Instruments, Inc., 52 F.3d 967, 976 (Fed. Cir. 1996), *aff'd* 517 U.S. 370 (1996). Notably, "secured" was only one of many terms disputed between the parties, and equal, if not greater, emphasis was placed by Adidas on the construction of several terms related to the focus of the '300 and '471 patent claims – the flexible member.

The District Court's claim construction decision largely adopted Akeva's proposed constructions, with the significant exception of the term "secured." Pet. App. 65a. The Court agreed with Akeva that the ordinary meaning of "secured" was "fastened" or "attached," *id.* at 37a, but concluded that Akeva had disclaimed the ordinary meaning for both patents. For the '471 patent, the Court interpreted "secured" to mean "a rear sole detachably secured below a portion of the upper." *Id.* at 47a. For the '300 patent, the District Court interpreted "secured" to mean "a rear sole selectively or permanently fastened, but not permanently fixed in position." *Id.* at 45a.[5] The Court concluded that Akeva had disclaimed the ordinary meaning of "secured" without addressing contrary evidence cited by Akeva and based on its view that a disclaimer "need not be explicit." *Id.* at 33a. The Court's approach to disclaimer reflected its observation

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[5] The Court interpreted "secured" in this strained manner in an attempt to account for the '300 patent specification's statement that the claimed flexible member "need not be used only in conjunction with a detachable rear sole, but can be used with permanently attached rear soles as well." Pet. App. 40a-41a. Rather than give "permanently attached" its inclusive ordinary meaning, the District Court limited that term by implication, citing several portions of the specification in purported support of defining "permanently attached" as "rotatable." *Id.* at 38a-39a, 41a. In fact, the '300 patent contains only one passing mention of a rear sole that is rotatable but not removable. *Id.* at 41a.

that the "somewhat inconsistent" analyses "advocated by the parties" *both* "are supported by Federal Circuit precedent." *Id.* at 35a. Because "[o]ver the years, the Federal Circuit had "taken two approaches to claim construction" – one "focused on the claim language and a second focused on the specification that is more likely to read limits into the claim" – the District Court expressed a hope that the forthcoming en banc decision in *Phillips* would "settle several questions on the appropriate method of analysis." *Id.* at 35a-36a.

On Akeva's motion for reconsideration, the District Court reaffirmed its *Markman* ruling in light of the *Phillips* en banc decision. Pet. App. 10a. The Court perceived a "renewed emphasis on the specification" in *Phillips*, which "lends strong support to the notion that a disclaimer or disavowal found in the specification cannot be ignored in construing claim terms." *Id.* at 16a. Thus, the Court reiterated that language in the '300 and '471 patent specifications "serves to limit" the ordinary meaning of "secured," *id.* at 19a, despite that ancestors of the patents distinguished between "secured" and "detachably secured" in claim language, *id.* at 17a. Finally, the District Court refused to consider a remark by the '300 patent examiner made during the prosecution of a continuation patent that the examiner always considered "secured" to have its ordinary meaning of "fastened" or "attached." *Id.* at 21a-22a.[6]

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[6] The Court claimed in a footnote that the patent examiner's statement was unhelpful because she did not elaborate on what the ordinary meaning was, Pet. App. at 22a, but as Akeva's District Court briefing made clear, the patent examiner's statement came in response to a filing by Akeva that stated that the "ordinary" meaning of "secured" would be "fastened" or "attached." Dist. Ct. Doc. 135 (Akeva Mot. for Partial Recon. filed June 6, 2005), at 5.

C. Proceedings Before the Federal Circuit

Because the District Court's claim construction decision was determinative of its infringement claims, Akeva accepted a summary judgment of non-infringement and appealed the District Court's construction of "secured" in both patents. The Federal Circuit affirmed.[7]

Citing *Cybor*, the Federal Circuit stated that "[a] district court's claim construction findings are reviewed de novo on appeal." Pet. App. 2a. However, the Court did not engage in a de novo analysis. It simply cited the strongest evidence it could find to support the District Court's conclusions, which it refused to "disturb." *Id.* at 6a; *see id.* at 8a (stating that the evidence cited by the District Court "supports [the] finding" it had reached). Thus, the Federal Circuit reached the same idiosyncratic conclusions as the District Court: for the '471 patent, the word "secured" meant "shoes with detachable heels," *id.* at 6a, whereas for the '300 patent, "secured" meant "shoes with rear soles that are secured to the shoe, but not permanently fixed." *Id.* at 9a.

The Federal Circuit's conclusions were based on its understanding that, pursuant to *Phillips*, "[t]he ordinary meaning of a term may be narrowed when interpreted in light of the specification." Pet. App. 4a. Thus, although reaching the same result as the District Court, the Federal

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[7] Pursuant to Federal Circuit Rule 47.6, the Court designated its opinion as "not citable as precedent." Pet. App. 1a. Since then, the Federal Circuit has deleted Rule 47.6 and adopted Federal Circuit Rule 32.1 to allow, consistent with the revised Federal Rules of Appellate Procedure, the citation of "nonprecedential dispositions issued after January 1, 2007." Fed. Cir. R. 32.1(c). This Court has not allowed the Federal Circuit's routine use of the "nonprecedential" designation to circumvent its review.

Circuit disagreed with the District Court's determination that the ordinary meaning of "secured" encompassed *all* shoes. To the contrary, citing *Phillips*, the Federal Circuit concluded that the District Court's strained construction of "secured" in the '471 patent "does not take the term outside its ordinary meaning," but merely "interpret[s the term] as it is used in accordance with the specification." *Id.* at 5a-6a. By remarkably construing the District Court's definition as consistent with ordinary meaning, the Federal Circuit sidestepped existing precedent requiring a clear disavowal in order to read a claim term contrary to its ordinary meaning.

The Federal Circuit's discussion of the '300 patent confirmed its view that *Phillips* had substantially relaxed the requirement of interpreting a claim according to its ordinary meaning absent a clear disavowal. Instead of first determining the ordinary meaning of "secured," the Federal Circuit immediately began identifying portions of the specification to support a disclaimer of conventionally soled shoes, without acknowledging contrary evidence presented by Akeva. Pet. App. 7a. The Federal Circuit relied heavily on *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001), which had found a disavowal of a claim term's ordinary meaning based on "all embodiments" language similar to a portion of the '300 patent specification.[8] Pet. App. 7a-8a. Yet the Federal Circuit conceded that, unlike the patent in *SciMed*, there could be no unequivocal disclaimer here, because the

[8] In the context of describing the detachable/rotatable rear sole of the *preferred embodiment* – not the flexible member that is the subject of the claims at issue in this lawsuit – the '300 patent stated that "[i]n all embodiments, the invention includes mechanical means for selectively locking the rear sole relative to the rear sole support and the upper of the shoe." Patent. App. 34a.

'300 patent specification expressly stated the patent's applicability to "permanently attached" soles – a term that, at least "at first blush," covers conventionally soled shoes. *Id.* at 8a.[9] Rather than reach the obvious conclusion of no disclaimer under *SciMed*, however, the Federal Circuit, citing *Phillips*, searched for a way to read the "permanently attached" language to exclude conventionally soled shoes. Like the District Court, the Federal Circuit concluded that the "'permanently attached' language in the specification contemplates shoes with heels that are permanently fixed (cannot be interchanged) but are rotatable." *Id.*

Although the Federal Circuit failed to address most of Akeva's evidence, it expressly refused to consider Akeva's '126 patent, an ancestor of the '300 patent. Pet. App. 9a. That patent demonstrated that Akeva used specific language – not "secured" or "permanently attached" – to claim a rotatably positionable sole. The Federal Circuit ruled that this evidence was categorically barred because the '126 patent "has a different disclosure than the '300 patent," *id.*, regardless of the materiality of any difference.[10]

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[9] The Federal Circuit's opinion twice states that the "disclaimer" here is "less equivocal" than in *SciMed*, Pet. App. 7a-8a, but context makes clear that the Court's word choice was erroneous. The Federal Circuit's discussion of *SciMed* centers on conflicting language in the '300 specification not present in *SciMed*, making the disclaimer in this case *more* equivocal than *SciMed* or *less* unequivocal than *SciMed*, but plainly not *less* equivocal.

[10] Akeva also cited its '210 patent, a grandparent of the '471 patent with an *identical* specification, to show that its claims distinguish between "detachably secured" and "secured." Pet. App. 17a. The Court simply ignored this point, which undermines its putative "same specification" rationale for not considering the '126 patent.

REASONS FOR GRANTING THE PETITION

I. CERTIORARI SHOULD BE GRANTED TO REMEDY THE FEDERAL CIRCUIT'S CONTINUED FAILURE TO SET FORTH AN INTELLIGIBLE STANDARD FOR DISCERNING WHEN PATENT CLAIMS MAY BE READ CONTRARY TO THEIR ORDINARY MEANING.

1. Pursuant to federal statute and longstanding practice, a patent has two key components, the claims and the specification. 35 U.S.C. § 112; *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996). As this Court has long recognized, the claims set forth the scope of the inventor's legally protected creation. *See, e.g., General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938) (claims "measure the invention") (quoting *Continental Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 419 (1908)). In contrast, the specification enables a person of ordinary skill in the art to implement the invention, including, at a minimum, its preferred embodiment, thereby giving the public a "meaningful disclosure in exchange for being excluded from practicing the invention for a limited period of time." *University of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 922 (Fed. Cir. 2004) (citation omitted).

Because of the centrality of claim language, this Court has repeatedly cautioned against importing limitations from the specification into claims. *See, e.g., General Elec. Co.*, 304 U.S. at 374 (cautioning against "improper importation into the claim of a factor nowhere described therein"); *McCarty v. Lehigh Valley Pub. R.R. Co.*, 160 U.S. 110, 116 (1895) ("if we once begin to include elements not mentioned

in a claim . . . we should never know where to stop"); *White v. Dunbar*, 119 U.S. 47, 51-52 (1886).[11]

However, the Court also has recognized a competing principle – the specification's ability to inform the claim construction analysis. *See, e.g.*, *United States v. Adams*, 383 U.S. 39, 48-49 (1966) ("[I]t is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." (citations omitted)); *Howe Machine v. National Needle*, 34 U.S. 388, 394 (1890) ("[T]he specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it different from what it is.").

This Court's most recent claim construction case, *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996), alluded to the tension between these two principles in ruling that claim construction is a question for the court, not a jury. The Court recognized that "[t]he claim 'define[s] the scope of a patent grant,'" *id.* at 373 (citation omitted), but also that a claim "term can be defined only in a way that comports with the instrument as a whole," *id.* at 380. The Court concluded that claim construction is best resolved by the Federal Circuit – the "exclusive appellate court for patent

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[11] Claims ensure that "'the limits of a patent [are] known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of a patent will be dedicated ultimately to the public.'" *Markman*, 517 U.S. at 390 (quoting *General Elec. Co.*, 304 U.S. at 369). As this Court has explained, the centrality of claim language "reliev[es] the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture." *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278 (1877).

cases," *id.* at 390; *see* 28 U.S.C. § 1295(a) – rather than by juries, because of the need for uniformity and predictability.

Thus, this Court has recognized, but has not yet resolved, the tension between two fundamental canons of patent law – that a claim is to be understood in light of the specification, but that the specification may not itself limit the claim. To date, that task has been left to the Federal Circuit.

2. Simply put, the Federal Circuit has not been up to the task. As recently observed by one Federal Circuit judge:

> The problem is that our decisions provide inadequate guidance as to when it is appropriate to look to the specification to narrow the claim by interpretation and when it is not appropriate to do so. Until we provide better guidance, I fear that the lower courts and litigants will remain confused.

SciMed, 242 F.3d at 1347 (Dyk, J., concurring).

It is not that the Federal Circuit is ignorant of the significance of the competing principles at issue or of the need for an intelligible framework to patrol the line between them. Indeed, the Federal Circuit has repeatedly recognized the "fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification." *Comark*, 156 F.3d at 1186-87; *see, e.g.*, *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1117 (Fed. Cir. 2004) (discussing the "longstanding difficulty in the contrasting nature of the axioms"). Moreover, the Federal Circuit has recognized the need to provide more guidance than mere invocation and repetition of these "twin axioms," because the "axioms themselves seldom provide an answer, but instead merely

frame the question to be resolved." *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904 (Fed. Cir. 2004).

Despite recognizing the need for a uniform, intelligible claim construction jurisprudence, the Federal Circuit became polarized after *Markman*. After setting forth basic principles in *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576 (Fed. Cir. 1996), "decisions of the Federal Circuit increasingly diverged . . . into two more or less opposing camps." R. CARL MOY, MOY'S WALKER ON PATENTS § 4:35 (2006). One camp "espoused a more formal, rule-based approach to claim interpretation that focused mainly on the language of the patent claim," whereas "the other camp, in contrast, approached the question more globally and with less dedication to any particular procedure." *Id.* This divide deepened substantially in 2002, when a Federal Circuit panel determined that dictionary definitions – not simply the claim language itself – should be the touchstone for claim interpretation. *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002); *see, e.g.*, MOY, *supra*, § 4:38 (explaining that the "distinction between these two camps has only sharpened over time," upon "statements giving heavy weight to the definitions set forth in published dictionaries"); DONALD S. CHISUM, CHISUM ON PATENTS § 18.03[1][d] (2007 Supp.) (noting the jurisprudential shifts "provoked by a 2002 panel decision that emphasized dictionary definitions of disputed claim terms").

Before *Phillips*, however, at least two principles appeared to have been settled. *First*, the claim construction analysis should begin by attempting to ascertain the ordinary meaning of the claim language. *See, e.g.*, *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed. Cir. 2002) ("We begin our claim construction analysis, as always, with the words of the claim."); *Hockerson-Halberstadt, Inc. v.*

Avia Group Int'l, 222 F.3d 951, 955 (Fed. Cir. 2000) (as "a starting point, the court gives claim terms their ordinary and accustomed meaning as understood by one of ordinary skill in the art"). Thus, despite the emerging dispute within the Federal Circuit concerning whether dictionaries should supply the ordinary meaning, there was a consensus that the claim language provided the starting point for claim construction. *See, e.g.*, ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT 33 (6th ed. 2004 Supp.) (discussing the "apparent emergence of a standard protocol for claim construction," pursuant to which "the analytical focus must begin with and remain centered on the language of the claims," and the specification should not be consulted "before any effort is made to discern the ordinary and customary meanings attributed to the words themselves").

Second, a "heavy presumption" was held to attach to the claim term's ordinary meaning, assuming the existence of such a meaning. *Teleflex*, 299 F.3d at 1325; *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002); *Johnson Worldwide Assoc., Inc. v. Zebco Corp.*, 175 F.3d 985, 988 (Fed. Cir. 1999); HARMON, *supra*, at 34. Rebutting that heavy presumption required "expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Teleflex*, 299 F.3d at 1325; *see e.g., Liebel-Flarshaim*, 358 F.3d at 906; *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003); *SciMed*, 242 F.3d at 1344. Thus, there was no disclaimer of ordinary meaning if "the alleged disavowal of claim scope is ambiguous." *Omega*, 334 F.3d at 1324.

3. In 2004, the Federal Circuit granted en banc review in *Phillips*, articulating seven questions for consideration and providing hope of enhanced clarity in claim construction. *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004)

(granting en banc review); *see, e.g.*, Holly L. Bonar, *Is Something Amiss? A Commentary on the Aftermath of* Phillips v. AWH Corp., 88 J. Pat. & Trademark Off. Soc'y 513, 518 (2006) ("As a result of the obvious disagreement over the proper method to interpret claim terms by members of the Federal Circuit, many observers anxiously awaited claim construction guidance from *Phillips* that might yield some certainty."); Crissa A. Cook, *Comment: Constructive Criticism:* Phillips v. AWH Corp. *and the Continuing Ambiguity of Patent Claim Construction Principles*, 55 Kan. L. Rev. 225 (2006) (discussing the optimism that *Phillips* would "alleviate the instability and uncertainly plaguing the federal appellate process for claim construction appeals").

At first blush, *Phillips* appeared ready to tackle what it considered "[t]he principal question": "the extent to which we should resort to and rely on a patent's specifieation in seeking to ascertain the proper scope of its claims." 415 F.3d at 1312. However, *Phillips* offered no new intelligible principle to resolve this question. To the contrary, it simply summarized and "reaffirm[ed]" the conflicting principles of claim construction it had previously articulated in a wide variety of cases. *Id.* at 1312 (stating that "the basic principles of claim construction outlined" in *Markman*, *Vitronics*, and *Innova* "are still applicable, and we reaffirm them today"). Tellingly, despite the sharp differences among the Federal Circuit judges pre-*Phillips*, nearly all of the judges concurred with this articulation of basic claim construction principles, calling into doubt whether that exposition provided a meaningful legal framework.

Worse still, *Phillips* cast doubt on two principles of claim construction that *had* emerged – the "heavy presumption" of ordinary meaning and the "clear disavowal" standard for rebutting ordinary meaning. The Court at first appeared to

reaffirm the presumption of ordinary meaning, absent "an intentional disclaimer or disavowal of claim scope." 415 F.3d at 1316 (citing *CCS Fitness* and *SciMed*). Yet, in rejecting over-reliance on dictionary definitions, *Phillips* criticized the "ordinary meaning" jurisprudence more broadly. Specifically, *Phillips* rejected the "*Texas Digital* approach" of using the ordinary meaning unless "the specification contains a sufficiently specific alternative definition or disavowal," because that approach "improperly restricts the role of the specification." *Id.* at 1320.

Thus, *Phillips* appeared to undermine the requirement of a clear disavowal to restrict the ordinary meaning of a claim term. Although the Court "recogniz[ed] that the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice," the only guidance offered in *Phillips* is no guidance at all. 415 F.3d at 1323. The Court merely expressed hope that "the line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms." *Id.* According to the Court, despite the "difficulties" of such freeform analysis, "resolv[ing] that problem in the context of the particular patent is likely to capture the scope of the actual invention" most accurately. *Id.* at 1323-24.

Adding further to the confusion is the result in *Phillips*, which *adopted* the ordinary meaning of a disputed term – "baffles" – 415 F.3d at 1324-38, despite criticizing reliance on ordinary meaning. *See* David Sanker, *Note:* Phillips v. AWH Corp.*:* *No Miracles in Claim Construction*, 21 Berkeley Tech. L.J. 101, 114 (2006) (*Phillips* "did not follow its own guidelines to determine the meaning of the term

'baffles'"). *Phillips* concluded that the term "should not be read restrictively to require that the baffles in each case serve all of the recited functions" in the specification. 415 F.3d at 1326-27 (citing *Liebel-Flarsheim*, 358 F.3d at 908).[12]

Had the panel in this case followed *Phillips*' claim construction analysis, as opposed to *Phillips*' general legal discussion, the ordinary meaning of "secured" would have controlled. Specifically, the Federal Circuit should not have required (as it did) every shoe covered by the patents to serve *both* primary functions disclosed in the specifications – extending shoe life (via a detachable/rotatable rear shoe sole) and enhancing spring (via a flexible member). *Cf.* Pet. App. 8a. Yet the internally inconsistent principles articulated in *Phillips* allowed the Court to do just that.

Not surprisingly, *Phillips* has been interpreted – including by the Federal Circuit here – to relax the heavy presumption previously accorded the ordinary meaning of claim terms. Pet. App. 4a. Other Federal Circuit panels and district courts have reached the opposite conclusion and continue to require a clear disavowal of ordinary meaning.[13]

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[12] It is settled that patentees are "not required to include within each of their claims all . . . advantages or features described as significant or important in the written description." *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1331 (Fed. Cir. 2004).

[13] Numerous post-*Phillips* decisions reflect competing views of the status of the "heavy presumption"/"clear disavowal" framework. *See, e.g.*, *Andersen Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1372 (Fed. Cir. 2007) (finding a clear disavowal of ordinary meaning but noting the "tightrope" walking required after *Phillips*); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1039, 1041 (Fed. Cir. 2006) (Newman, J., dissenting from denial of en banc rehearing) (chiding the panel majority for adopting the ordinary meaning of a claim term after *Phillips*); *Honeywell Int'l,*

As commentators have noted, *Phillips* did not bring clarity to claim construction, but rather provided a kitchen sink of principles that can be used to justify any desired outcome. *See, e.g.*, CHISUM, *supra*, § 18.03[1][d] (questioning "whether *Phillips* will influence the result in particular cases involving claim construction"); MOY, *supra*, §§ 4.39, 4.40 (explaining the "murky nature of the en banc decision"); Bonar, *supra*, at 513 ("After *Phillips*, claim construction jurisprudence remains in disarray as the Federal Circuit appears to be applying different parts of its *Phillips* ruling in different cases."); Cook, supra, at 253. Two dissenters in *Phillips* anticipated this precise situation. *See Phillips*, 415 F.3d at 1330 (Mayer, J., dissenting) ("we say nothing new, but merely restate what has become the practice over the last ten years – that we will decide cases according to whatever mode or method results in the outcome we desire, or at least allows us a seemingly plausible way out of the case").

4. Clarification of the fundamentally important issue of patent law presented by this case is possible. Indeed, prior to *Phillips*' about-face, the Federal Circuit was progressing with a framework of presumptive ordinary meaning and

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Inc. v. ITT Indus., 452 F.3d 1312, 1318-20 (Fed. Cir. 2006) (applying a relaxed disavowal standard in light of *Phillips*' emphasis on the specification); *nCube Corp. v. Seachange Int'l, Inc.*, 436 F.3d 1317, 1321-22 (Fed. Cir. 2006) (refusing to limit the ordinary meaning of claim language, over Judge Dyk's *Phillips*-based dissent); *Nystrom v. Trex Co., Inc.*, 424 F.3d 1136, 1144 (Fed. Cir. 2005) (adopting a limited claim construction after *Phillips*, and not requiring a clear disavowal of ordinary meaning); *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1308-09 (Fed. Cir. 2005) (applying the "clear disavowal" standard in refusing to limit the claim construction in light of *Phillips*).

clear disavowal.[14] The problem is that the Federal Circuit has proved incapable of adhering to a framework for when claims may be read contrary to their ordinary meaning. Instead, the Court continues to issue unpredictable decisions and to apply ever-changing and conflicting frameworks, leaving inventors, litigants and lower courts in a state of palpable and debilitating confusion. Absent an intelligible framework for navigating the "fine line" between claim and specification, that line is disintegrating. This Court's intervention is necessary.

This case presents an ideal vehicle for resolving the question presented. *First*, the Federal Circuit's approach to claim construction – namely, ignoring the ordinary meaning and any support for it, and combing the patent specification for a basis for limiting the claims – was determinative. Had the Federal Circuit applied a heavy presumption of ordinary meaning and required a clear disavowal, it would have been required to apply the ordinary meaning of "secured." As the Federal Circuit conceded, the specification was equivocal with respect to the meaning of "secured," Pet. App. 7a-8a, and thus could not provide a clear disavowal of the term's ordinary meaning.[15] *Second*, the decision below is incorrect.

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[14] As this Court has observed, such an about-face unfairly upsets the settled expectations of inventors such as Petitioner. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731-32 (2002) ("courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community").

[15] Akeva presented abundant evidence supporting the ordinary meaning of "secured" and demonstrating no clear disavowal of conventionally soled shoes, including: (1) the "permanently attached" language in the '300 patent specification; (2) the use of "secured" consistent with its ordinary meaning throughout the '300 and '471 patent specifications; (3) the prior claiming of

The panel's unprincipled approach plainly conflicts with the presumptive ordinary meaning and "clear disavowal" framework that was widely accepted before *Phillips* and that *Phillips* actually employed on its facts. As this Court has recognized in the context of other patent doctrines, an analysis based on presumptions is often the best way to balance the at-times competing goals of certainty and promoting innovation. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731-32 (2002).

The unprincipled nature of the decision below perhaps becomes most vivid when the Federal Circuit's actual claim constructions are considered. The Federal Circuit concluded that a commonly understood word – "secured" – should be given two counter-intuitive, conflicting meanings – one for the '300 patent and one for the similar '471 patent.[16] In irreconcilable contrast, the Federal Circuit remarked that the term that had been most hotly disputed by the parties below – "flexible member" – was an "inclusive term" to be read according to its ordinary meaning. Pet. App. 2a. Moreover, the Federal Circuit reached its conclusions despite clear evidence from the prosecution history that "secured" simply

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detachable/rotatable soles by ancestors of the '300 and '471 patents, and the differentiation in the claims of those ancestral patents among "secured," "detachably secured," and "rotatably positionable"; (4) the patent examiner's remark that she had always interpreted "secured" to mean "fastened" or "attached"; and (5) the fact that there was only one passing reference in the '300 patent specification to rotatable, non-removable soles, located columns away from the "permanently attached" language. The Federal Circuit's approach rendered this evidence irrelevant.

[16] For the '471 patent, "secured" means "detachably secured," whereas for the '300 patent, "secured" means "secured to the shoe, but not permanently fixed." Pet. App. 5a, 9a.

had its ordinary meaning of "fastened" or "attached." *See infra* Section III. Simply put, claim construction should not be an exercise in cherry-picking portions of the specification to support a court's visceral reaction that conflicts with the plain meaning of the claims. Other doctrines exist – such as invalidity – to rein in overbroad patent claims.

5. This Court has not yet addressed the Federal Circuit's perennially inconsistent approach to the relationship between the ordinary meaning of a claim and the specification. Caution may have been warranted prior to *Phillips*, which held the promise of bringing some clarity. But, as explained, *Phillips* has done nothing but make matters worse. *See, e.g.*, Sanker, *supra*, at 121-22 (after *Phillips*, it "would be a miracle" for the Federal Circuit to "resolve the riddle of 'construing the claims in light of the specification without importing limitations from the specification'").

Moreover, *Phillips* is merely one in a long line of the Federal Circuit's illusory promises of clarity. For example, the United States, in opposing certiorari in *Alloc, Inc. v. United States Int'l Trade Comm'n*, 342 F.3d 1361 (Fed. Cir. 2003), assumed the validity of concerns like those raised here, but claimed that any confusion would be alleviated by *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313 (Fed. Cir 2002), which supposedly "articulated a clear standard for determining when a claim term should be limited based on the specification and prosecution history." U.S. Opp., *Alloc, Inc. v. United States Int'l Trade Comm'n*, No. 03-1187, at 10-11 (2004). But the "clear standard" attributed to *Teleflex* is the precise "ordinary meaning" and "clear disavowal" framework that, only two years later, was rendered obsolete by *Phillips*. *See id.* The Court should not allow the theoretical possibility of eventual clarity from the Federal Circuit to thwart its review of a fundamental,

important and recurring question of patent law. Immediate review by this Court is warranted. *See* S. Ct. R. 10(c).[17]

II. THIS COURT'S INTERVENTION IS NEEDED TO ENSURE THAT THE FEDERAL CIRCUIT ACTUALLY CONDUCTS THE CRITICAL DE NOVO CLAIM CONSTRUCTION ANALYSIS THAT IT PURPORTS TO REQUIRE.

1. Since *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998), the Federal Circuit has purported to apply de novo review to all aspects of a district court's claim construction. The Federal Circuit based that holding on *Markman*, explaining that the "Supreme Court endorsed this court's role in providing national uniformity to the construction of a patent claim," and that such "a role . . . would be impeded if we were bound to give deference to a trial judge's asserted factual determinations incident to claim construction." *Id.* at 1455.

Cybor has been hotly debated since its inception. Although it has had several opportunities to revisit *Cybor* – most recently, in *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 457 F.3d 1293, *reh'g denied*, 469 F.3d 1039 (Fed. Cir. 2006), *pet. for cert. filed*, No. 06-1291 (March 22, 2007) – the Federal Circuit has refused, generating impassioned intracircuit debate. For instance, six separate opinions in *Amgen* reacted to the refusal to rehear the decision en banc.[18]

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[17] Notably, the petition for certiorari denied in *Phillips* (No. 05-602) did not present a substantive claim construction issue, but only raised the suitability of the de novo standard of review – an issue not reached by the *Phillips* majority.

[18] The *Amgen* petition for a writ of certiorari properly presents the de novo review question, but without the substantive claim

2. Vociferous cries for revision of *Cybor* are not its only opposition. In practice, *Cybor* has been eroded by Federal Circuit panels that do not engage in an actual de novo claim construction. Some Federal Circuit panels have expressly refused to apply *Cybor* strictly. *See, e.g.*, William H. Burgess, *Comment: Simplicity at the Cost of Clarity: Appellate Review of Claim Construction and the Failed Promise of Cybor*, 153 U. Pa. L. Rev. 763, 786-87 (2004) (explaining that "some federal judges have been reluctant to apply [*Cybor*] strictly"). These panels have grounded their view in the concurrences in *Cybor*, which stated that certain, unspecified aspects of a district court's claim construction ruling "should be accorded significant weight." *Cybor*, 138 F.3d at 1463 (Bryson, J., concurring); *see, e.g.*, *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 696, 713 (Fed. Cir. 1998).

Other Federal Circuit panels have similarly undermined *Cybor*, but with less pomp. Rather than conduct an actual de novo review, these panels determine if "the record supports the district court's interpretation." *LNP Eng'g Plastics v. Miller Waste Mills*, 275 F.3d 1347, 1356 (Fed. Cir. 2001); *see, e.g.*, *Utah Med. Prods. v. Graphic Controls*, 350 F.3d 1376, 1382-83 (Fed. Cir. 2003); *Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1304 (Fed. Cir. 2002).

In this case, the Federal Circuit, though purporting to apply the de novo standard, Pet. App. 2a, applied a relaxed

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construction issues presented here. Review of this case is warranted regardless of whether certiorari is granted in *Amgen*. However, this case would provide an extremely suitable companion to *Amgen*. Together, these two petitions present the aspects of the Federal Circuit's claim construction jurisprudence in most pressing need of review. At the very least, this case should be held for consideration pending resolution of *Amgen*.

standard of review akin to the cases noted above. The panel merely considered whether the evidence cited by the District Court "supports" the conclusions it had reached, Pet. App. 8a, ultimately determining that there was no basis for "disturb[ing] the district court's claim construction," *id.* at 6a. Thus, rather than methodically consider the claim language, the specification, the prosecution history, and other relevant sources, the Federal Circuit merely identified evidence in support of the District Court's claim constructions, to which the Federal Circuit deferred. In so doing, the Federal Circuit ignored conflicting evidence presented by Akeva (including evidence ignored by the District Court) and blinded itself to the prosecution history, including ancestral patents showing that "secured" was not synonymous with detachable or rotatable. *See supra* n.15.[19]

3. This Court's intervention is necessary to ensure, as the Federal Circuit has not, that the Federal Circuit actually employs the de novo standard mandated by *Cybor*. At present, litigants cannot be sure what standard of review actually applies until they receive the Federal Circuit's

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[19] A proper de novo analysis also requires consideration of relevant intrinsic evidence not in the District Court record. The Federal Circuit further erred and split from other authority by refusing to take judicial notice of highly probative portions of the prosecution history – namely, additional ancestral patents not part of the District Court record – which showed that Akeva's patent claims regularly use "secured" pursuant to its ordinary meaning. *Compare* Order of April 4, 2006 (denying Akeva's request for judicial notice), *with*, Fed. R. Evid. 201(d) ("A court *shall* take judicial notice if requested by a party and supplied with the necessary information." (emphasis added)); *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 954 n.27 (Fed Cir. 1993) (taking judicial notice of a patent "not part of the record on appeal").

opinion. This issue is of obvious importance, as it affects all claim construction appeals. And there is an acute interest in "providing national uniformity to the construction of a patent claim." *Cybor*, 138 F.3d at 1455 (citing *Markman*, 517 U.S. at 390). Absent de novo review, litigants lack a meaningful appeal to the court uniquely suited to adjudicate claim construction. *See Markman*, 517 U.S. at 390. Working back from a district court's conclusions to locate the best evidence in support of a reviewing court's visceral reaction – as in this case – is inconsistent with de novo review and its rationales of fairness, correctness and uniformity.

This case provides an excellent vehicle for resolving the question presented. Had the Federal Circuit conducted a proper analysis – starting from the words of the claim rather than from the District Court's conclusions – "secured" would have received its ordinary meaning.[20]

III. THIS COURT SHOULD RECTIFY THE FEDERAL CIRCUIT'S REFUSAL TO CONSIDER HIGHLY PROBATIVE ANCESTRAL PATENTS.

This Court's review is urgently needed to ensure that courts actually do consider all relevant intrinsic evidence, as *Phillips* purports to require. The decision below deepens confusion concerning when ancestral patents may be used to illuminate the meaning of claims in the patent at issue.

The Federal Circuit refused to consider highly probative ancestral patents in the record, which showed that Akeva has carefully distinguished between claiming, on one hand, the

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[20] Even if aspects of certain lower court decisions may deserve deference – *e.g.*, those involving highly technical matters or oral testimony, *cf. Amgen Inc.*, No. 06-1291 – the basic interpretation of patent text at issue here does not deserve deference.

broad class of shoes with "secured" soles and, on the other hand, the narrower classes of shoes with "detachably secured" or "selectively rotatable" soles. Pet. App. 9a. Such differential claiming "provides strong support" for reading "secured" pursuant to its ordinary meaning. *Liebel-Flarsheim*, 358 F.3d at 910; *see, e.g.*, *Comark*, 156 F.3d at 1187 ("There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims." (citation omitted)).

The panel's decision to ignore this critical prosecution history places it within a split of authority. The panel cited *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340 (Fed. Cir. 2004), for the claim that related patents may only be considered if they have the same specification. Pet. App. 9a.[21] But whether the specifications were identical was not dispositive in *Microsoft*, which held that "the prosecution history of one patent is relevant to an understanding of the scope of a common term in a second patent stemming from the same parent application." *Id.* at 1349-50 (citing *Jonsson v. Stanley Works*, 903 F.2d 812, 818 (Fed. Cir. 1990)).

Other Federal Circuit cases similarly conflict with the decision below by making clear that the determinative factor is family relationship, not identity of specification. *See, e.g.*, *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1289 (Fed. Cir. 2005) ("Because [the] patents all derive from the same parent application and share many common terms, we must interpret the claims consistently across all asserted

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[21] The Court applied this reasoning to the '126 patent, an ancestor of the '300 patent with a materially similar specification. The Court simply did not address the '210 patent – an ancestor to the '471 patent with an *identical* specification – despite that its reading of *Microsoft* required it to consider the '210 patent.

patents."); *Goldenberg v. Cytogen*, 373 F.3d 1158, 1167 (Fed. Cir. 2004) (the Federal Circuit "draws a distinct line between patents that have a familial relationship and those that do not").

Not only is this issue the subject of a Federal Circuit divide, but it is also important and recurring. And it is critical to the outcome of this case. Had the Federal Circuit consulted the '126 and '210 patents (ancestors of the '300 and '471 patents, respectively), it would have been crystal clear that Akeva distinguishes in claiming "secured," "detachably secured," and "rotatably positionable" rear soles. Consideration of these patents would have made it impossible for the Federal Circuit to maintain its strained readings of "secured" in the patents at issue here. There is no basis for the Federal Circuit's refusal to consider highly probative ancestor patents. Without instruction from this Court, however, that practice is certain to continue.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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April 12, 2007

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APPENDIX

Appendix A

Note: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

06-1090

AKEVA L.L.C.,
Plaintiff-Appellant,

v.

ADIDAS-SALOMON AG,
Defendant,

and

ADIDAS AMERICA, INC.,
Defendant-Appellee.

DECIDED: November 13, 2006

Before MICHEL, *Chief Judge*, PLAGER, *Senior Circuit Judge*, and RADER, *Circuit Judge*.

RADER, *Circuit Judge*.

Akeva L.L.C. (Akeva) is a company which has been assigned and licenses a portfolio of footwear patents. Akeva sued adidas America, Inc. (adidas) for infringement of

certain claims of two of its patents: U.S. Patent No. 6,662,471 (the '471 patent) and U.S. Patent No. 6,604,300 (the '300 patent).[1] These patents describe improvements to athletic shoe heels. According to Akeva, the specifications of the '300 and '471 patent describe a "flexible member"[2] improvement that can be incorporated in rear soles that are detachable, or rotatable, or permanently secured. The district court construed these patents as covering shoes with rotatable or detachable rear soles only. *See Akeva L.L.C. v. adidas Am., Inc.*, 1:03-CV-01207 (M.D.N.C. May 17, 2005) (*Claim Construction Decision*); *Akeva L.L.C. v. adidas Am., Inc.*, 385 F. Supp. 2d 559 (M.D.N.C. 2005) (*Reconsideration Decision*)[3]. Because adidas shoes have permanently-fixed rear soles that do not rotate, Akeva accepted entry of summary judgment of non-infringement and appealed the district court's claim construction to this court. *Akeva L.L.C. v. adidas Am., Inc.*, 1:03-CV-01207 (M.D.N.C. Oct. 28, 2005) (*Final Judgment*). Because the district court correctly construed the term "secured," the summary judgment of non-infringement is *affirmed.*

I

A district court's claim construction findings are reviewed de novo on appeal. *Cybor Corp. v. FAS Techs.*

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[1] Akeva asserted claims 93, 94, 100-106, 109, 117, 118, 121-154, 192-194, and 204-232 of the '300 patent, and claims 1-32 of the '471 patent against adidas.

[2] "Flexible member" is an inclusive term given to describe the U-shaped member of the '471 patent and the flexible plate of the '300 patent.

[3] The district court reconsidered its claim construction decision in light of this court's intervening decision in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), but did not deviate from its original construction.

Inc., 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc). A grant of summary judgment is also reviewed de novo. *Bell Atl. Network Servs., Inc. v. Covad Commc'ns Group, Inc.*, 262 F.3d 1258, 1266-67 (Fed. Cir. 2001). This court has jurisdiction under 28 U.S.C. § 1295(a)(1).

The central issue of this appeal is the meaning of the term "secured" as it is used in the '300 and '471 patents. Claim 93 of the '300 patent, for example, claims:

> A shoe comprising:
>
> an upper having a heel region;
>
> a rear sole *secured* below the heel region of the upper; and
>
> a flexible plate having upper and lower surfaces and positioned between at least a portion of the heel region of the upper. . . .

'300 patent, col. 20 ll.29-43 (emphasis added).

The '471 patent also uses the term "secured." For example, claim 1 states:

> A shoe comprising:
>
> an upper, and
>
> a rear sole *secured* below a portion of the upper, the rear sole comprising:
>
> > a member having a top wall with a lower surface . . . the member having a bottom wall . . . the forward regions of the top and bottom walls being connected at a close end by a curved wall. . . .

'471 patent, col. 13 ll.6-50 (emphasis added).

Akeva argues that the ordinary meaning of the claim should be given to the term and that the ordinary meaning would encompass permanent, removable, and rotatable soles to athletic shoes. adidas argues that the specifications of the '300 and '471 patents disavow rear soles that are not detachable or rotatable.

This court construes claims in accordance with the principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Claim language governs claim interpretation. *Id.* at 1312. Claim terms, however, are construed in light of the specification. *Id.* at 1315. The ordinary meaning of a term may be narrowed when interpreted in light of the specification. *Id.* at 1316.

A. The '471 Patent

The '471 patent is directed to athletic soles with interchangeable soles which "provide extended and more versatile life and better performance in terms of cushioning and spring." Col. 1 ll.13-17. The '471 patent states that "an athletic shoe can be changed dramatically if it is simply given interchangeable rear soles." *Id.* at col. 2 ll.54-55. In particular, the specification describes shoes with "interchangeable/detachable rear soles" to address problems with uneven wear patterns. *Id.* at ll.14-15, 26-27. While Akeva argues that the invention of the '471 patent is the flexible membrane, the language of the '471 specification specifically states that the invention of the '471 patent is an athletic shoe with a detachable heel: "However, in a radical departure from conventional shoes, the shoe of the present invention incorporates a heel structure, including *a detachable rear sole*, that significantly alleviates heel wear problems associated with conventional soles and provides enhanced cushioning and/or spring." *Id.* at col. 4 ll.56-61 (emphasis added).

Akeva argues that the catch-all phrase at the end of the '471 patent specification, which states "[t]hus, it is intended that the present invention cover all possible combinations of the features shown in the different embodiments, as well as modifications and variations of this invention, provided they come within the scope of the claims and their equivalents," precludes a claim construction which comprises only detachable heels. Col. 13 ll.1-5. No embodiments, however, of the '471 patent include permanently attached heels. Of course, the absence of an embodiment does not necessarily exclude that embodiment from the scope of the invention. *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004). But here, the specification when read as a whole clearly demonstrates that the scope of the invention is athletic shoes with detachable heels which may include an optional flexible plate. *See* '471 patent, col. 4 ll.62-col. 5 ll.4 ("An embodiment of the heel structure . . . includes . . . a rear sole detachable secured to the rear sole support. . . . In addition, the heel structure may include a flexible plate for providing spring to the heel of the user and reducing wear caused by midsole compression."). Akeva cites *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1331 (Fed. Cir. 2004), in which the court found no disclaimer where the specification states the invention "includes" some feature where it is only one of several features described as significant or important. However, this case is distinguishable because the detachable sole of the '471 patent is not one of several features, it is the primary feature of the invention.

Indeed, when the '471 patent uses the term "secured," it uses it to describe a rear sole which is "detachably secured." Col. 3 ll.14-17. Finding that the term "secured" applies only to shoes with detachable heels does not take the term outside its ordinary meaning. Rather, the term is interpreted as it is

used in accordance with the specification; "secured" does allow for removability. As this court has stated in *Phillips*, "[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." 415 F.3d at 1316. In other words, an inventor cannot get more than he or she invents. *On Demand Mach. Corp. v. Ingram Indus. Inc.*, 442 F.3d 1331, 1344 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1316 and *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 397-98, 181 Ct. Cl. 55 (1967)) ("[while] each term standing alone can be construed as having varying degrees of breadth, each term must be construed to implement the invention described in the specification"). The district court construed this term as used in the '471 patent to mean "a rear sole detachably secured below a portion of the upper." *Claim Construction Decision* at 28. As such, this court will not disturb the district court's claim construction that the '471 patent covers shoes with detachable heels.

B. The '300 Patent

The '300 patent specification also discloses athletic shoes with extended life by improving the rear sole such that the rear sole is rotatable, detachable, or both. The '300 patent notes that the soles of prior art athletic shoes tend to wear out faster than the shoe itself. Col. 1 ll.2-42. Further, athletic shoe performance cushioning also tends to wear out faster than the shoe itself. *Id.* at ll. 44-46. In order to solve this problem, the '300 patent specification discloses shoes that can be rotated into different positions to allow for more even wear to the sole of the athletic shoe. Col. 6 ll.56-59. Or, in a preferred embodiment, the rear sole can be detached, allowing the athletic shoe owner to change the sole

depending on the cushioning and other features desired for a particular activity. Col. 4 ll.42-46.

The district court construed the term "secured" in the '300 patent to mean "selectively or permanently fastened, but not permanently-fixed into position." *Claim Construction Decision* at 25. Akeva argues on appeal that the invention of the '300 patent is a flexible plate that can be used in shoes with rotatable, detachable, or permanently fixed heels. To support its argument for this claim interpretation here, Akeva points to language in the '300 patent specification which states "[t]he flexible region also need not be used only in conjunction with a detachable rear sole, but can be used with permanently attached rear soles as well." Col. 10 ll.12-16. Akeva also argues that a related patent, U.S. Patent 5,560,126 (the '126 patent), claims a "detachably secured" rear sole and a rear sole that allows for "selective rotation" and that this supports its claim that such soles are not the claimed invention of the '300 patent. Thus, Akeva argues, the asserted claims of the '300 patent cover permanently-fixed soles that will or will not rotate and which contains a flexible plate.

In *SciMed Life Systems Inc. v. Advanced Cardiovascular Systems Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001), this court stated "[w]here the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question." In *SciMed*, the language of the specification contained a "broad and unequivocal" disclaimer of dual lumens in catheters. 242 F.3d at 1344. The language of the '300 patent specification is less equivocal than that in *SciMed*. Here, the '300 patent

states contains the "all embodiments" language discussed in *SciMed*: "[i]n all embodiments, the invention includes mechanical means for selectively locking the rear sole relative to the rear sole support and upper of the shoe." Col 7 ll.17-20. The "all embodiments" language of the '300 patent specification however, appears at first blush to conflict with the "permanently attached rear soles" language, creating a less equivocal disclaimer than that of *SciMed*. Col. 7 ll.17-20; col. 10 ll.12-16.

Nevertheless, the "permanently attached" language, when read in the context of the specification, supports a finding that the '300 patent specification disclaims permanently attached rear soles that do not at least rotate. *Phillips*, 415 F.3d at 1316. The "permanently attached" language in the specification contemplates shoes with heels that are permanently fixed (cannot be interchanged) but are rotatable. For example, the '300 patent specification states that "the rear sole may not be removable but only rotatably positionable." Col. 7 ll.42-43, *see also* col 6:58-63, col. 7 ll.35-44; Fig. 3 of the '300 patent. In addition, the '300 patent specification discusses as a problem of prior art shoes with heels the shoe owner is "stuck" with. Col. 2 ll.2-3. In order to solve this problem and other problems, the '300 patent contemplates athletic shoes with rear soles that can be rotated or replaced. Col. 6 ll.33-45.

As the district court noted: "Akeva has cited no statement in the '300 Patent's specification, and this court has found none, that would contemplate a rear sole that is permanently locked into position.' *Claim Construction Decision* at 25. Accordingly, one skilled in the art reading the specification of the '300 patent specification would understand the term "secured" as used in the '300 patent to

mean shoes with rear soles that are secured to the shoe, but not permanently fixed.

Further, while this court has considered prosecution of earlier patents in the construction of claim terms used in later issued patents, *see Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1349-50 (Fed. Cir. 2004), in those cases, the patents had the same specification. Here, the '126 patent on which Akeva relies has a different disclosure than the '300 patent.

Therefore, this court construes the term "secured" in accordance with the district court.

II. Infringement

Akeva concedes that if the claims are construed to only cover detachable or rotatable heels, adidas does not infringe its claims. Thus, this court affirms the district court's entry of summary judgment of non-infringement in favor of adidas.

Appendix B

UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF NORTH CAROLINA

1:03CV01207

AKEVA L.L.C.,
Plaintiff,

v.

aDIDAS AMERICA, INC.,
Defendant.

MEMORANDUM OPINION and ORDER

OSTEEN, District Judge

In this patent infringement action relating to the technology of athletic shoes, the court now reconsiders its Memorandum Opinion and Order of May 17, 2005 (the "Claim Construction Order"), in light of the recent en banc opinion of the Federal Circuit Court of Appeals in *Phillips v. AWH Corporation*, 415 F.3d 1303 (Fed. Cir. 2005). The court also herein considers Plaintiff's Motion for Partial Reconsideration of the Court's Claim Construction Order and Memorandum in Support Thereof. For the reasons stated below, the court will reaffirm its prior ruling and will deny Plaintiff's motion.

I. BACKGROUND

On May 17, 2005, this court issued the Claim Construction Order that construed the disputed claim terms.

The Claim Construction Order construed all terms to have their plain and ordinary meaning, with one exception. The term "secured" in both United States Patent No. 6,604,300 ("'300 Patent") and United States Patent No. 6,662,471 ("'471 Patent") was held to have a meaning more restrictive than its plain and ordinary meaning. The court found language in the specifications of the '300 and '471 Patents that disavowed or disclaimed claim scope, limiting the definition of the word "secured."

Plaintiff now asks the court to reconsider its ruling and to construe the term "secured" in both patents according to its plain and ordinary meaning. In addition, the Federal Circuit has since issued an en banc opinion in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), that clarifies several aspects of claim construction doctrine on which the court relied in its analysis, requiring that the court review its ruling. *See also Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004) (order granting rehearing en banc). The parties have submitted briefs discussing the impact of *Phillips* on the court's claim construction ruling.

The court will first address *Phillips*, and then will address Plaintiff's motion.

II. *PHILLIPS V. AWH CORPORATION*

In relevant part, the Federal Circuit's discussion in *Phillips* clarifies the role of intrinsic and extrinsic evidence, especially dictionaries and the specification, in defining the scope of a patent's claims. In addition to reaffirming the principles established in *Markman v. Westview Instruments*, Inc., 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384 (1996), *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996), and *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111 (Fed.

Cir. 2004), the court realigned its method of analysis to downplay the role of dictionaries. *Phillips v. AWH Corp.*, 415 F.3d 1303, Nos. 03-1269, 03-1286, slip op. at 7-8 (Fed. Cir. Jul. 12, 2005).[1]

The Federal Circuit reiterated that the claims define the patentee's property rights and should be at the center of any claim construction analysis. *Id.* at 12. Additionally, the court emphasized that the meaning of claim terms must be ascertained from the point of view of one skilled in the art. *Id.* at 9. A court should begin its claim construction analysis from the "objective baseline" of the ordinary and customary meaning that a person skilled in the art would understand a claim term to have. *Id.* A court should also assume that a person skilled in the art would read the claims "in the context of the entire patent, including the specification." *Id.* at 10.

The specification is a statutory requirement, and the law requires that it "contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same." 35 U.S.C. § 112, ¶ 1. Thus, "the specification necessarily informs the proper construction of the claims." *Phillips*, Nos. 03-1269, 03-1286, slip op. at 15. It is "entirely appropriate," then, for a court to "rely heavily" on the written description when construing claim terms. *Id.* at 16.

The Federal Circuit points to two ways in which the specification may limit the scope of claim terms. First, the patentee may have directed a special definition for a claim term. *Id.* In this case, the patentee's lexicography will control the meaning of the term or terms. *Id.* Second, "the

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[1] The page numbers cited for *Phillips v. AWH Corp.* will refer to the pagination in the slip opinion.

specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor." *Id.* In this situation, the "inventor's intention, as expressed in the specification, is regarded as dispositive." *Id.* (citing *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343-44 (Fed. Cir. 2001)).

The *Phillips* opinion also reiterates that the prosecution history is a useful source of information regarding how the Patent and Trademark Office and the inventor understood the invention. *Id.* at 17. In addition to reviewing the specification, a court may look to whatever portions of the prosecution history are in evidence. *Id.* This information is often less useful, however, because it tends to be less clear than the specification or even ambiguous. *Id.* To the extent it shows the inventor's understanding and whether the inventor limited the scope of the patent during prosecution, it may be helpful. *Id.*

With regard to extrinsic evidence (i.e., evidence outside the patent and its prosecution history), the Federal Circuit again indicated that district courts should place limited emphasis on it. This type of evidence, including dictionaries, can be used to aid the court's understanding of the field of the invention and the underlying technology. *Id.* at 18. Dictionaries, in particular, may be used to "assist the court in determining the meaning of particular terminology to those of skill in the art of the invention." *Id.* at 19. In general, however, extrinsic evidence is less reliable than intrinsic evidence and should be used only "in the context of the intrinsic evidence." *Id.* at 21. Because extrinsic evidence is not part of the patent and was not produced "for the purpose of explaining the patent's scope and meaning," it may have been created for a different audience, have the potential for bias, be misleading, and pose the risk of

contradicting or undermining the public record of the patent. *Id.* at 20.

Generally, the specification and prosecution history should take precedence over dictionaries. In *Texas Digital Systems, Inc. v. Telegenix, Inc.*, the Federal Circuit previously described dictionaries and similar technical sources as "particularly useful resources" for courts in determining the ordinary meaning of a claim term, and recommended consulting a dictionary as the first step in claim construction – before consulting the written description or prosecution history. 308 F.3d 1193, 1202 (Fed. Cir. 2002). In *Phillips*, the court explained that the methodology it set out in *Texas Digital* was focused on helping courts avoid "one of the cardinal sins of patent law – reading a limitation from the written description into the claims." *Phillips*, Nos. 03-1269, 03-1286, slip op. at 22 (quoting *SciMed*, 242 F.3d at 1340). The result, however, "improperly restrict[ed] the role of the specification in claim construction." *Id.* at 24. To avoid focusing the inquiry on the abstract definition of words from a dictionary, the *Phillips* court encouraged more focus on the claim terms in the context of the specification. *Id.* at 25. "Properly viewed, the 'ordinary meaning' of a claim term is its meaning to the ordinary artisan after reading the entire patent." *Id.*

The *Phillips* opinion noted that the duty of the patentee was to understand and describe his invention. Dictionary definitions are supposed to be broad and expansive, but a patent applicant must be more precise. *Id.* at 26. Because the patentee did not create the dictionary for the purpose of describing the invention, there could be a conflict between "the patentee's responsibility to describe and claim his invention[] and the dictionary editors' objective of aggregating all possible definitions for particular words." *Id.*

at 25. The court showed concern that the use of broad dictionary definitions as the first step in claim construction had led to "unduly expansive" constructions of claim terms, extending patent protection "beyond what should properly be afforded by the inventor's patent." *Id.* at 26. This "risk of systematic overbreadth" could be substantially corrected if the analysis began, instead, with the claims, specification, and prosecution history. *Id.*

While the Federal Circuit discussed various weaknesses of dictionaries and technical treatises in construing patent claims, it also made clear that these sources "are often useful to assist in understanding the commonly understood meaning of words and have been used both by our court and the Supreme Court in claim interpretation." *Id.* at 28. They have the advantage of being unbiased and accessible to the public prior to litigation. *Id.*

Finally, the opinion cautions that courts should watch the often difficult line between construing the terms in light of the specification and importing limitations from the specification. *Id.* Courts should keep their focus on "understanding how a person of ordinary skill in the art would understand the claim terms." *Id.* at 29.

In realigning its claim construction analysis, the Federal Circuit stated that "there is no magic formula or catechism." *Id.* at 30. "The sequence of steps used by the judge" will not matter so long as the court "attach[es] the appropriate weight to be assigned to those sources in light of the statutes and policies that inform patent law." *Id.* at 31.

Having summarized the relevant discussion from the *Phillips* opinion, the court now must reassess its prior ruling to determine whether the Federal Circuit's renewed focus on intrinsic evidence, especially on the terms and specification,

requires a fresh look at the disputed terms. The court will only reconsider its ruling as to claim terms that were disputed by the parties.

A. "Secured"

The most debated term at issue in this case is the term "secured" found in both the '300 and '471 Patents. This is the only claim term not given its plain and ordinary meaning because the court found language in the specifications of both patents evidencing a clear disavowal of claim scope. The court's construction of "secured" relied heavily on principles established in *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, where the Federal Circuit held that when the specification clearly excludes a particular feature, "that feature is deemed to be outside the reach of the claims of the patent." 242 F.3d at 1341. This is true even if the claim language, on its own, could otherwise encompass that feature. *Id.*

The *Phillips* court reaffirmed *SciMed*, stating that an inventor's disclaimer or disavowal of claim scope is one way in which the specification may limit the meaning of claim terms. *Phillips*, Nos. 03-1269, 03-1286, slip op. at 16. Thus, the principle of disclaimer or disavowal on which this court relied in its Claim Construction Order remains alive. Further, the renewed emphasis on the specification, over and above the prosecution history, dictionaries, and other evidence, lends strong support to the notion that a disclaimer or disavowal found in the specification cannot be ignored in construing claim terms. The court sees no need to alter its construction of "secured" in light of *Phillips*.

Akeva argues in its *Phillips* brief that the court's ruling improperly limited the patent's scope to one or more embodiments described in the specification. (Pl.'s Mem.

Law Concerning Impact *Phillips v. AWH Corp.* Matter at 3-4.) However, Plaintiff mischaracterizes the nature of the court's ruling. The court did not find any implicit limitation of the term "secured" based on a lack of information about other possible forms, but rather found an explicit disavowal of a permanently positioned rear sole by express language in the '300 Patent and of a permanently attached rear sole by express language in the '471 Patent. (Mem. Op. & Order of May 17, 2005 at 25, 28.)

Plaintiff further argues that the court's erroneous limitation of the term "secured" is evidenced by the fact that such limitation would render claim language found in related patents to be superfluous. (Pl.'s Mem. Law Concerning Impact *Phillips v. AWH Corp.* Matter at 3-4.) The Federal Circuit has cited the principle that a court should normally construe the same terms consistently across patents created from the same parent application when they share a single written description. *See, e.g., NTP, Inc. v. Research in Motion, Inc.*, 2005 WL 1806123, ___ F.3d ___, (Fed. Cir. Aug. 2, 2005). In regard to the '471 Patent and its parent application, Patent No. 5,806,210 (the "'210 Patent"), the patents share the same written description, and the written description of the '210 Patent includes the same language of disavowal that is present in the '471 Patent: "In a radical departure from conventional shoes, *the shoe of the present invention incorporates a heel structure, including a detachable rear sole*, that significantly alleviates heel wear problems associated with conventional soles and provides enhanced cushioning and/or spring." '210 Patent, col. 4, 11. 51-56 (emphasis added). The '210 Patent is not at issue in this litigation, and the court will not address whether this language creates an express disclaimer of claim scope in that patent. For the purposes of this litigation, the disclaimer in the '471 Patent is not per se inapplicable to the same

language found in other, related patents that use the same written description. This rule of construction does not require the court to ignore a patent's express disclaimer of claim scope.

Plaintiff next argues that the main thrust of the claims in the patents-in-suit is the so-called "flexible member," which is a distinct feature from the detachable or repositionable sole not claimed in the '300 or "471 Patents. The language of disclaimer on which the court relies relates only to the detachable or repositionable sole, and so, Plaintiff argues, this language should be held inapplicable to the claim terms in these patents. (Pl.'s Mem. Law Concerning Impact *Phillips v. AWH Corp.* Matter at 5.) The court finds this argument without merit. The court must take the patent as it exists on the public record, and cannot pick and choose which aspects of the written description should apply and which should not. All of the language and figures contained in the specification comprise the "context" of the patent discussed in *Phillips*, and it must be considered as a whole. *Phillips*, Nos. 03-1269, 03-1286, slip op. at 10 (stating that a person of ordinary skill "is deemed to read the claim term . . . in the context of the entire patent"). If Plaintiff wished for certain language in the specification to be considered inapplicable to the claims, it should have left that language out of the specification. Because it remains in the patent, the court must consider it.

Plaintiff's final argument, that the court improperly used the specification to provide "structure" to the term "secured," is also without merit. (Pl.'s Mem. Law Concerning Impact *Phillips v. AWH Corp.* Matter at 7.) The court's limitation on the term "secured" was not occasioned by the term's lack of structure in the claims, and the court did not find any such problem with the claims. Rather, the court found the explicit

language in the specification to be a clear disclaimer or disavowal of claim scope.

The Federal Circuit's en banc opinion in *Phillips* does not require that this court alter its previous ruling. Therefore, the court reiterates its finding that the language of disclaimer or disavowal of scope in the '300 and '471 Patents, discussed at length in the Claim Construction Order, serves to limit the scope of the term "secured" as discussed in the prior opinion.

B. The Other Disputed Terms

The remainder of the disputed terms were given their plain and ordinary meaning by this court, and the analysis appears to remain fully supported after *Phillips*. The "flexible plate" was given its plain and ordinary meaning after consideration of the written description. (Mem. Op. & Order of May 17, 2005 at 32.) The "direction substantially perpendicular" was given its plain and ordinary meaning after an assessment of the written description and a limited review of the "300 Patent's prosecution history. (*Id.* at 38, 44.) The terms "concave," "oriented toward a back of the shoe," and "element" were all given their ordinary meaning after assessing the claim terms themselves and the specification. (*Id.* at 45, 48, 50.) Indeed, the plain and ordinary meaning of the terms was generally not at issue. The parties merely disputed whether this definition should apply in light of other facts.

Although the court relied heavily on dictionary definitions in construing the terms, it attempted to use the dictionary only as a convenient resource to compose the definitions. The use of dictionaries in composing the definitions of nontechnical terms was approved in *Phillips*. *See Phillips*, 415 F.3d 1303 at 28 (describing dictionaries as

"useful" and stating "we do not intend to preclude the appropriate use of dictionaries"). The *Phillips* court was concerned, however, with a court beginning its analysis with the dictionary because such definitions are often quite expansive and could give the terms undue breadth. *Id.* at 26. This court considered several arguments for narrowing the scope of the disputed terms, but found none of them warranted a more restrictive construction. The court believes it attached the appropriate weight to the claims and the specification, and that its use of dictionary definitions was consistent with the patentee's use of the terms within the patent. The terms at issue here were not technical terms subject to any unique definitions in the field of athletic shoe design, and the use of a standard English-language dictionary was appropriate and helpful in composing the claim constructions.

After reviewing the patents-in-suit, the disputed terms, and the Claim Construction Order, the court finds that *Phillips* would not require any change in the constructions given. Thus, the court reaffirms its prior ruling on the remaining disputed terms.

III. PLAINTIFF'S MOTION FOR PARTIAL RECONSIDERATION

Before the Federal Circuit issued its *Phillips* opinion, Plaintiff moved for reconsideration of the Claim Construction Order on a number of grounds. The Claim Construction Order is not a final judgment or order in this case, but is an interlocutory ruling. District courts have the power to reconsider their interlocutory rulings at their discretion until a final judgment has been entered in the case. *Moses H. Cone Mem'l Hosp. v. Mercury Constr. Corp.*, 460 U.S. 1, 12, 103 S. Ct. 927, 935 (1983); *American Canoe Ass'n v. Murphy Farms, Inc.*, 326 F.3d 505, 514-15 (4th Cir.

2003). The Federal Rules of Civil Procedure do not set out any standard for reconsideration of interlocutory orders, but only provide they are "subject to revision at any time before the entry of judgment." Fed. R. Civ. P. 54(b).

Various judicial doctrines, such as the "law of the case," have evolved to guide a court's discretion. Public policy favors an end to litigation and recognizes that efficient operation requires the avoidance of rearguing questions that have already been decided. *See Official Comm. of Unsecured Creditors of Color Tile, Inc. v. Coopers & Lybrand, L.L.P.*, 322 F.3d 147, 167 (2d Cir. 2003) ("Where litigants have once battled for the court's decision, they should neither be required, nor without good reason permitted, to battle for it again." (internal quotations omitted)). Most courts have adhered to a fairly narrow set of grounds on which to reconsider their interlocutory orders and opinions. Courts will reconsider an interlocutory order in the following situations: (1) there has been an intervening change in controlling law; (2) there is additional evidence that was not previously available; or (3) the prior decision was based on clear error or would work manifest injustice. *See Official Comm.*, 322 F.3d at 167; *United States v. Duke Energy Corp.*, 218 F.R.D. 468, 474 (M.D.N.C. 2003); *Potter v. Potter*, 199 F.R.D. 550, 552-53 (D. Md. 2001).

Plaintiff raises several arguments in support of its motion to reconsider. First, it contends that the court should consider a recent statement by the patent examiner of the '300 Patent, stating she construed the term "secured" during the prosecution of this patent to have its plain and ordinary meaning. This statement was made during the prosecution of a later, but related, patent. Presumably, Plaintiff considers this to be additional evidence that was not previously available. Defendant argues, among other things, that this

statement is extrinsic evidence and should not be considered by the court.

The court will not consider the examiner's statement as additional evidence because it is extrinsic to the '300 Patent. The intrinsic record is fixed when the patent is granted. *Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193 at 1202; *see also Vitronics*, 90 F.3d at 1583 ("The claims, specification, and file history . . . constitute the public record of the patentee's claim, a record on which the public is entitled to rely."). Here, the patent examiner made the statement during the prosecution of a different patent nearly two years after the '300 Patent issued. In arguing for relevancy, Akeva cites to *Microsoft Corp. v. Multi-Tech Systems, Inc.*, 357 F.3d 1340 (Fed. Cir. 2004), *cert. denied*, ___ U.S. ___, 125 S. Ct. 61 (2004), but the *Microsoft* court did not rely on subsequent statements by the patent examiner. Rather, it relied on the patentee's statements as evidence of how it understood its own invention, and it used these statements to narrow the meaning of the claims. *Id.* at 1349-50. Here, Akeva attempts to use the examiner's statement to broaden the scope of its claims, a proposition unsupported by the case law Akeva cites.[2] *See also Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005) ("The purpose of consulting the prosecution history in construing a claim is to 'exclude any interpretation that was disclaimed during prosecution.'") (quoting *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1580 (Fed. Cir. 1988). As such, the patent examiner's statement will not be considered.

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[2] The examiner's statement, even if considered, would be unhelpful to the court because it is quite vague. The examiner states that she used the ordinary meaning of "secured," but she does not elaborate on what this "ordinary meaning" was.

Plaintiff next advances several arguments grounded on the notion that the court committed error in its claim construction analysis. Plaintiff contends that the court either failed to recognize certain aspects of the patent specifications or incorrectly understood the inventions. The asserted errors do not appear to rise to the level of "clear error." Many of the references Akeva cites were discussed in the Claim Construction Order, and other references were available to the court.[3] Akeva's arguments point out, at most, possible errors of analysis which are better addressed on appeal. The court will not allow the parties to reargue claim construction.[4]

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[3] The argument that comes closest to an assertion of clear error is that the court failed to understand the '300 Patent discloses two inventions: the claimed rear sole and the claimed flexible plate. The court disagrees with Akeva's notion, although the difference may be one of pure semantics. In the court's opinion, the 300 Patent discloses a single invention, which is a shoe with two features, a rear sole and a flexible plate (with characteristics as claimed).

[4] It may be helpful for the court to address one argument made by Plaintiff contending the court failed to recognize an embodiment in which part of the rear sole is permanently fixed in place and part is rotatable or adjustable. This embodiment is not excluded from the court's construction of "secured" as used in the '300 Patent. The court construed the term to mean that a rear sole "secured" is one that is "selectively or permanently fastened, but not permanently fixed in position." (Mem. Op. & Order of May 17, 2005 at 25.) A rear sole in which only one portion (e.g., the periphery of the sole) can be rotated, moved, removed, or similarly physically adjusted could be encompassed within this definition because the rear sole, as a whole, would not be permanently fixed in position. The court declines to adjust its construction on this ground.

Because Plaintiff has not advanced any situation compelling the court to reconsider the Claim Construction Order, the court declines to reconsider its opinion further.

IV. CONCLUSION

For the reasons set forth above,

IT IS ORDERED that after reconsideration of its ruling in light of an intervening change in the law in *Phillips v. AWH Corp.*, the court reaffirms its analysis and the claim constructions in the Memorandum Opinion arid Order of May 17, 2005;

IT IS FURTHER ORDERED that Plaintiffs' Motion for Partial Reconsideration of the Court's Claim Construction Order [135] is DENIED.

This the 26th day of August 2005.

William L. Osteen, United States District Judge

Appendix C

UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF NORTH CAROLINA

1:03CV01207

AKEVA L.L.C.,
Plaintiff,

v.

aDIDAS[1] AMERICA, INC.,
Defendant.

MEMORANDUM OPINION and ORDER

OSTEEN, District Judge

Plaintiff Akeva L.L.C. ("Akeva") brings this patent infringement action against Defendant adidas America, Inc. ("adidas"). Plaintiff asserts Defendant infringed United States Patent No. 6,604,300 entitled "Athletic Shoe with Improved Sole" ("'300 Patent") and United States Patent No. 6,662,471 entitled "Athletic Shoe with Improved Heel Structure" ("'471 Patent"), in violation of 35 U.S.C. § 271(a) and (b). The patents were acquired by inventor David F. Meschan and assigned to Akeva.

A determination of patent infringement requires two steps. *Markman v. Westview Instruments. Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370, 391, 116 S. Ct.

[1] The company's trade name begins with a lowercase "a."

1384, 1396 (1996). First, the "meaning and scope of the patent claims asserted to be infringed" must be determined. *Id.* Second, the properly construed claims must be compared to the product that is accused of infringing. *Id.* The first step, an assessment of the meaning and scope of patent claims, is a matter of law and, thus, the duty of the district court. This has now been the subject of full briefing by the parties and a hearing (the "*Markman* hearing"), and the court herein sets out the proper construction of the disputed claim terms in the '300 and '471 Patents.

I. FACTUAL BACKGROUND

Many aspects of the '300 Patent, and a few details of the '471 Patent, are in contention. This section gives a general description of the claimed inventions, with more complete descriptions of the claims given in the Analysis section, below.

A. The 6,604,300 Patent

The '300 Patent discloses an athletic shoe with a rear sole whose features enhance the usefulness, durability, and performance of the shoe. Beginning with Claim 93, which is the first claim Akeva asserts is infringed, the patent discloses a rear sole "secured" below the heel region of the shoe. The heel region incorporates a flexible plate that is supported at its periphery, has a void beneath its interior area, and is capable of deflection at its interior. Generally speaking, the flexible plate acts like a trampoline, cushioning the impact of the wearer's heel and providing extra spring. The '300 Patent claims several variations on this theme. Central to one of the disputes is a feature wherein the heel can be separated from the rest of the shoe by the wearer, allowing a new heel to be attached in its place. This allows the wearer to replace the heel when it becomes worn or when the wearer

needs different cushioning and spring properties for a different activity, such as playing basketball rather than running. There is also a feature that allows the heel to be rotated by the wearer so that the fast-wearing, ground-engaging portion located at the very back of the heel is no longer ground-engaging, thereby giving the heel a longer life. The parties disagree whether the "spirit" of the invention should be the flexible plate, as Plaintiff contends, or the removability and rotatability of the heel, as Defendant argues.

B. The 6,662,471 Patent

The '471 Patent discloses an athletic shoe heel that is constructed in the shape of a "U" lying on its side. This recumbent U is made of top and bottom walls generally parallel to each other and joined at one end by a curved wall or bend. As a wearer adds weight to the heel, the structure absorbs the impact. The energy in the components of the recumbent U add spring by returning to their original positions after deflection and as the wearer's weight shifts. A "stiffening member" can be added at the bend between the walls to increase this springing effect.

II. ANALYSIS

Here, the court tackles the first step in a patent infringement determination, which is to construe the language of the patent. First, an explanation of the appropriate method of analysis is given, including the evidence a district court may properly consider and the weight to be given to different types of evidence. Second, the court construes the disputed claim terms.

A. Applicable Law

1. The Court Should Consider Intrinsic Evidence to Construe the Claims, and May Consider Extrinsic Evidence, if Needed.

A court should use three sources to determine the meaning of claims: (1) the language of the claims themselves, (2) the patent's specification, and (3) the patent's prosecution history. *Markman*, 52 F.3d at 979. These three sources are the intrinsic evidence and should always be consulted.

A court should "first . . . look to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention." *Vitronics Corp. v. Conceptronic. Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). The second step is to look to the specification. The claims define the invention, but the specification "is always highly relevant" and "is the single best guide to the meaning of a disputed term." *Id.* Within the specification is a written description of the invention that would allow someone skilled in the art to make the invention described. *Markman*, 52 F.3d at 979. "For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claim." *Id.* Claim terms "must be read in view of the specification, of which they are a part." *Id.* A court should consider, for instance, whether the specification uses terms inconsistently with their ordinary meaning. *See Vitronics*, 90 F.3d at 1582. A court should also consider any explicit statements of meaning, such as when a patentee has acted as his own lexicographer, giving special definitions to words used in the specification. If the patentee has clearly redefined a word in the specification, then the meaning of that word or term will be construed in the way the patentee has defined, rather than

using the word's ordinary meaning. *Markman*, 52 F.3d at 980. However, the specification and its written description "do[] not delimit the right to exclude" others from using the information because "that is the function and purpose of claims." *Id.*

The prosecution history, sometimes called the "file wrapper," is the third type of intrinsic evidence to consult, if it is in evidence. *Id.*; *Vitronics*, 90 F.3d at 1582. "This 'undisputed public record' of proceedings in the Patent and Trademark Office is of primary significance in understanding the claims." *Markman*, 52 F.3d at 980. The "specification and claims are in the words of the patentee" and the construction they bear on their face "may be confirmed by what the patentee said when he was making his application." *Id.* (quoting *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227, 12 Otto 222 (1880)). If the patentee disclaimed or surrendered scope in order to obtain an allowance of the claims, such as to distinguish the invention from prior art, then the patentee would be estopped from reincorporating this disclaimed scope into the claims. *Pall Corp. v. Micron Separations. Inc.*, 66 F.3d 1211, 1218 (Fed. Cir. 1995). "Although the prosecution history can and should be used to understand the language used in the claims, it . . . cannot 'enlarge, diminish, or vary' the limitations in the claims." *Markman*, 52 F.3d at 980 (quoting *Goodyear Dental Vulcanite*, 102 U.S. at 227).

When the intrinsic evidence fails to resolve an ambiguity in a disputed term, extrinsic evidence may be consulted. *Vitronics*, 90 F.3d at 1583. This evidence includes all evidence outside the patent and its prosecution history, such

as expert testimony,[2] the inventor's testimony, a company's marketing materials or other statements, dictionaries, and learned treatises. *Markman*, 52 F.3d at 980. A court may use this evidence to aid its understanding of the patent, but may not use it to vary or contradict the terms used in the claims. *Id.* at 981. The use of extrinsic evidence is only proper if the intrinsic evidence – the public record – is unclear. *Vitronics*, 90 F.3d at 1583.

2. The Court Should Begin Its Construction with the Claim Language.

"In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves." *Tex. Digital Sys. v. Telegenix, Inc.*, 308 F.3d

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[2] The Federal Circuit has indicated aversion to the use of expert testimony in claim construction. In *Markman*, the court stated that the testimony of the inventor and his patent attorney was entitled to no deference because it amounted to no more than a legal opinion on the proper construction of the claims. *Markman v. Westview Instruments. Inc.*, 52 F.3d 967, 983 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370, 391, 116 S. Ct. 1384, 1396 (1996). In a later decision, the Federal Circuit went further: "*Markman* requires us to give no deference to the testimony of the inventor about the meaning of the claims." *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1580 (Fed. Cir. 1996) (emphasis added). Additionally, the Federal Circuit has stated that any expert testimony, "whether it be of an attorney, a technical expert, or the inventor, on the proper construction of a disputed claim term . . . may only be relied upon if the patent documents, taken as a whole, are insufficient to enable the court to construe disputed claim terms." *Vitronics Corp. v. Conceptronic. Inc.*, 90 F.3d 1576, 1585 (Fed. Cir. 1996). The court continued that in such "rare instances," prior art documents and dictionaries are preferred because they are objective, reliable, and are accessible to the public at the time of the invention. *Id.*

1193, 1201 (Fed. Cir. 2002) (internal quotations omitted). There is a "heavy presumption" that the terms in the claims "mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." *Id.* at 1202. To consult the written description and prosecution history before looking to the ordinary meaning would risk importing limitations into the claims and would violate the precedent of the Federal Circuit. *Id.* at 1203. It could lead a court, for example, to use an embodiment of the invention to limit the claim terms. This would be error, however, because embodiments should serve only as an exemplary form.

In determining the ordinary meaning, a court may look to dictionaries and treatises, which have been long considered "particularly useful resources." *Id.* at 1202. Although a dictionary or treatise is extrinsic evidence, it is to some extent an exception to the general rule. "Judges are free to . . . rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." *Vitronics*, 90 F.3d at 1584, n.6. A patent serves as public notice of its claims, and the dictionaries, encyclopedias, and other references "publicly available at the time the patent is issued[] are objective resources that serve as reliable sources of information" on a term's meaning. *Tex. Digital*, 308 F.3d at 1202-03. These types of references are "unbiased reflections of common understanding," untainted by expert testimony, subsequent events, the parties' motives, and the litigation itself. *Id.* at 1203. A court may consult these materials at any time during litigation, whether introduced into evidence or not. *Id.* When a word has multiple definitions, a court should look to the intrinsic record to determine which of these meanings "is

most consistent with the use of the words by the inventor." *Id.*

Once the ordinary meaning is determined, the full intrinsic record "must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted." *Id.* at 1204. The ordinary meaning may be rebutted or limited in three situations relevant here. *See CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). First, it will be rebutted if "the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning." *Tex. Digital*, 308 F.3d at 1204. In this situation, the statement made in the specification "must have sufficient clarity to put one reasonably skilled in the art on notice that the inventor intended to redefine the claim term." *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1370 (Fed. Cir. 2005). Second, ordinary meaning will be rebutted if "the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Tex. Digital*, 308 F.3d at 1204. In this situation, the patentee has "distinguished his invention from a prior art reference, expressly disclaimed subject matter, or highlighted a particular feature as important to the invention." *W.E. Hall Co. v. Atlanta Corrugating LLC*, 370 F.3d 1343, 1353 (Fed. Cir. 2004). A third situation that requires a definition other than the ordinary meaning is "where the term or terms chosen by the patentee so deprive the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999); *see also Tex. Digital*, 308 F.3d at 1204.

The redefinition of a claim term (and, thus, the rebuttal of its ordinary meaning) must be unambiguous enough to put one skilled in the art on notice of the different meaning. *Bell Atl. Network Serv. v. Covad Comms. Group, Inc.*, 262 F.3d 1258, 1268 (Fed. Cir. 2001). If a claim term merely is susceptible to more than one interpretation, the intrinsic evidence is ambiguous, or if the patentee's intent to depart from the ordinary meaning is less than clear, the inventor cannot be said to have clearly set out his own definition of that term and the ordinary meaning is not rebutted. *See Merck*, 395 F.3d at 1371; *W.E. Hall*, 370 F.3d at 1353. Additionally, inconsistency will not be enough. "Varied use of a disputed term in the written description demonstrates the breadth of the term rather than providing a limited definition." *Johnson Worldwide*, 175 F.3d at 991.

While redefinition must be clear, it need not be explicit. *Bell Atl.*, 262 F.3d at 1268. "The specification may define claim terms 'by implication' such that the meaning may be 'found in or ascertained by reading of the patent documents.'" *Id.* (quoting *Vitronics*, 90 F.3d at 1582). A patentee may be said to have defined a claim term by implication if he has used the term "throughout the entire patent specification [] in a manner consistent with only a single meaning." *Id.* at 1271. In *Bell Atlantic*, the court looked to the written description to construe the term "mode," which it found "broad and amorphous" enough to require some limitation. *Id.* at 1269. In reviewing the written description, the Federal Circuit found the patentee's statement that the system "operates in one of three selectable modes," followed by descriptions of three modes, limited the term and showed it to be distinct from the "rate" of data flow. *Id.* at 1272. The court rejected the notion that it was limiting the claim term based on a preferred embodiment because there was no authority that allowed a broadening of

claim terms "beyond their support in the specification." *Id.* at 1273 (internal quotations omitted). Also, the patent had been consistent in its redefined use of "mode" throughout the specification. *Id.*

B. The Parties' Methods of Analysis

The parties, in proposing their preferred claim constructions to the court, take different views of the proper claim construction analysis. Akeva argues, with regard to all its proposed constructions, that the claim terms should be defined according to their plain and ordinary meaning. It is the claim terms, it asserts, not the written description, figures, or other segments of the patent, that define the scope of its property rights. While the specification must provide enough support for the claims sufficient to teach someone skilled in the art how to make or use the invention, the specification should not be used to limit the claims. To this end, Akeva relies heavily on dictionary definitions.

As Akeva asserts, deviation from the heavy presumption of plain and ordinary meaning is only allowed when the patentee has chosen to be his own lexicographer and redefined a term, or when the "term lacks such clarity that there is 'no means by which the scope of the claim may be ascertained from the language used.'" (Mot. & Mem. Supp. Claim Construction of Akeva L.L.C. ("Akeva's Markman Brief") at 8 (quoting *Novartis Pharms. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1334 (Fed. Cir. 2004)).) A definition contrary to the ordinary meaning is only supported by a "deliberate and clear preference for this alternative definition." (*Id.* at 10 (quoting *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364, 1368 (Fed. Cir. 2003)).) Akeva also emphasizes that when the specification describes embodiments of the invention, these embodiments should be taken as examples only, and not as limitations on the claims.

A description of a "preferred" embodiment or an omission of a possible embodiment does not affect the requirement that the claims should be given "the full breadth of their plain meaning." (*Id.* at 9.)

adidas, on the other hand, takes a more context-specific view. adidas focuses on the "objective test" of what the claims would have meant to someone skilled in the art at the time of the invention. (adidas' Markman Br. Correct Constr. Disputed Claim Terms ("adidas' Markman Brief") at 2.) This requires a review of the claim language, the specification, and the prosecution history, but with more, focus on the specification than Akeva would support. adidas argues the court must look, first, to the ordinary meaning of the claim terms. "If the ordinary meaning is consistent with the manner in which the patentee uses the term in the claim, specification, and prosecution history, then the term is construed to have its ordinary meaning." (*Id.* at 3.) If there is more than one possible ordinary meaning, the correct definition will be the one that best comports with the way the patentee uses the term in the claims, specification, and prosecution history. If no ordinary meaning is consistent with the patentee's use, then the court must reject ordinary meaning and construe the term according to the patentee's use. adidas relies on the notion that "the meaning of a technical term in a patent claim is determined in accordance with its *usage in the specification*, elaborated if appropriate by the prosecution history and with due consideration to usage in the field of invention." (*Id.* (quoting *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1326 (Fed. Cir. 2004)).)

The analyses advocated by the parties, although somewhat inconsistent, are supported by Federal Circuit precedent. Over the years, the Federal Circuit has taken two approaches to claim construction: one focused on the claim

language and a second focused on the specification that is more likely to read limits into claims. John Josef Molenda, *Understanding the Federal Circuit's Internal Debate and Its Decision to Rehear Phillips v. AWH Corp. En Banc*, 86 J. Pat. & Trademark Off. Soc'y 911, 911 (2004). The court's most recent decisions appear to be shifting away from the specification-based approach and back to a claims-based approach. *Id.* at 920-21. However, the court has granted a rehearing en banc in the case of *Phillips v. AWH Corp.*, specifically focused on seven questions that encompass the vast majority of its claim construction doctrine. 376 F.3d 1382 (Fed. Cir. 2004). The outcome of this case could settle several questions on the appropriate method of analysis. However, until and unless the Federal Circuit amends its claim construction doctrine, this court must apply the law as it now stands.

C. The 6,604,300 Patent's Disputed Claim Terms

The first independent claim of the '300 Patent that Akeva asserts is infringed by adidas is Claim 93. This claim discloses the following invention (emphasis added to disputed terms):

> 93. A shoe comprising:
>
> an upper having a heel region;
>
> a rear sole *secured* below the heel region of the upper;
>
> and
>
> a *flexible plate* having upper and lower surfaces and positioned between at least a portion of the rear sole and at least a portion of the heel region of the upper, *peripheral portions of the plate being restrained from movement relative to an interior portion of the plate in a direction substantially perpendicular to a major*

> *axis of the shoe so that the interior portion of the plate is capable of being deflected relative to the peripheral portions in a direction substantially perpendicular to the manor axis of the shoe,* the *upper surface having at least one concave portion,* and the lower surface being at least in part visible from outside of the shoe.

Several of these terms appear in subsequent independent claims 117, 118, 121, 122, 192, and 204 and their dependent claims, which Akeva asserts are also infringed by adidas.

1. "Secured"

Both the '300 Patent and the '471 Patent use the term "secured," and the court will address its meaning in both patents in this section. The plain and ordinary meaning is not contested by the parties. In the context of a physical object, "to secure" is "to make fast: tie down." Webster's Third New Int'l Dictionary 2053 (1986). Akeva asserts that "secured" should be interpreted according to its plain and ordinary meaning of "fastened" or "attached," which would encompass permanent, removable, and rotatable attachment. adidas, on the other hand, argues that this plain meaning is rebutted because the specifications do not use the word to mean simply "fastened." Rather, the specifications contemplate that the heels "secured" to the shoe are always removable, or "selectively locked into position." The court will first address the proper construction of the term "secured" in light of the specification of the '300 Patent, and then address the proper construction in light of the '471 Patent's specification.

With regard to the '300 Patent, adidas' argument relies, first, on the introductory portion of the written description that details the background and summary of the invention.

The background discusses three problems with the state of the art for athletic shoes: (1) outsole wear, wherein the outer periphery of the heel wears out much faster than the rest of the shoe and requires replacement of the entire shoe when most of it remains in good shape; (2) midsole compression, wherein the midsole loses its cushioning effect, especially in the heel area; and (3) lack of customization options, which requires the costly acquisition of a different shoe for each type of athletic activity (e.g., tennis, basketball, running), creates an inability to customize shoes to an individual wearer's weight and preferences, and leaves few options for those suffering from foot or leg injuries or other irregularities. '300 Patent, col. 1, l. 32-col. 2, l. 12. It further describes that

> to achieve [advantages to be set forth in the written description, claims, and drawings] and in accordance with the purpose of the invention . . ., the shoe includes an upper having a heel region, a rear sole *secured* below the heel region of the upper, and a rear sole support *attached* to the upper and *configured to secure* the rear sole below the heel region of the upper.

Id., col. 2, ll. 27-33 (emphasis added). The written description later states, "The *present invention* includes a shoe or shoe kit *which includes or can accept a plurality of rear soles* 150[3] having different characteristics and/or surface configurations, thereby providing a cross trainer shoe." *Id.*, col. 6, ll. 33-36 (emphasis added).

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[3] In quotations of the patents in suit, the court has generally included the patentee's numerical references to components depicted in the specification.

adidas also points to several examples of language in the specification that support its argument for a more limited construction of "secured." Most notably, the specification states, "In *all embodiments, the invention includes* mechanical means for selectively locking the rear sole relative to the rear sole support and upper of the shoe." *Id.*, col. 7, 11. 17-20 (emphasis added). The specification also describes a manner for connecting a rear sole to a rear sole support, illustrated in Figure 2 in the specification:

> *To secure* rear sole 150 to rear sole support 140, rear sole 150 is simply press-fitted into . . . . *This manner of locking* rear sole 150 into the shoe at any one of several positions is one of several mechanical ways in which the rear sole can be removed, repositioned, and/or locked to the rear sole support or other part of a shoe.

Id., col. 5, 11. 14-20 (emphasis added). The specification further describes that "since rear sole 150 . . . is selectively positionable relative to rear sole support 140 . . ., it may be moved to a plurality of positions with a means provided to allow the user *to secure* the rear sole at each desired position." *Id.*, col. 6, 11. 46-51 (emphasis added). The specification's written description explains that the shoe depicted in its Figure 1 "also includes a rear sole 150 that is *detachably secured* to and/or rotatably positionable relative to rear sole support 140." *Id.*, col. 4, 11. 43-45 (emphasis added).

Akeva argues, in opposition to adidas' proposed construction, that the '300 Patent's specification does not purport to redefine the term "secured," nor does it disavow the plain and ordinary meaning. For this reason, it would be legal error to construe the term "secured" to incorporate adidas' additional limitation of "detachable." The written

description, Akeva argues, references permanently attached rear soles as a possible embodiment: "The flexible region also need not be used only in conjunction with a detachable rear sole, but can be used with permanently attached rear soles as well." *Id.*, col. 10, 11. 14-16. If "secured" meant "detachably secured," it would exclude this disclosed embodiment of the patent, which is a violation of a basic rule of claim construction. Akeva also argues that the term "secured" is used in contexts where detachability is not contemplated, such as in reference to a flexible member that may "have a U-shaped cushioning member placed on or *secured* to their top surface." *Id.*, col. 11, 11. 59-60. The written description does not use "secured" exclusively in referencing the connection of the rear sole to the rest of the shoe, because "attached" is used in discussing the connection between the rear sole and the rear sole support: "the rear sole is *attached* to the rear sole support." *Id.*, col. 8, 11. 24-25. Finally, Akeva argues that Meschan's previous patents show that when he wants to claim detachability, he makes a specific reference to this feature. Claim 25 of Meschan's prior U.S. Patent Number 5,560,126 (the "'126 Patent"), incorporated by reference into the '300 Patent, includes the component "a rear sole secured below the heel region of the upper," and then makes a dependent claim 40 that references "the shoe of claim 25, including means for detachably securing the rear sole below the heel region." U.S. Patent No. 5,560,126 (issued Oct. 1, 1996), col. 16, 11. 40-53. If the meaning of "secured" included the notion of detachability, this would impermissibly merge Claims 25 and 40 in the '126 Patent, another violation of a rule of claim construction.

Akeva is correct that the term "secured" as used in the '300 Patent's claims should not be construed to mean "detachably secured." This limitation is neither in the plain

meaning of "secured," nor does the written description disavow an invention with a permanently attached rear sole. For instance, the written description describes an embodiment wherein the rear sole is rotatable so that the "worn portion will no longer be in the location of the user's first heel strike" and states that "the rear sole may be rotated without separating it from the rear sole support." '300 Patent, col. 6, 11. 58-63. The written description later reiterates that "the rear sole may not be removable but only rotatably positionable." *Id.*, col. 7, 11. 42-43. However, adidas' proposed construction of "selectively locked into position" does not require detachability. As the patent's written description points out, the rear sole of a shoe could be selectively locked into position (e.g., rotatable) without also being detachable from the shoe.

While the specification does not disavow permanent attachment, it does contain an express statement that disclaims a rear sole permanently fixed in place. The written description specifically states that "in *all embodiments*, the invention includes mechanical means for selectively locking the rear sole relative to the rear sole support and upper of the shoe." *Id.*, col. 7, 11. 17-20 (emphasis added). While this statement uses the word "includes," generally interpreted in claim language as an open-ended word allowing for other possible features, Manual of Patent Examining Procedure § 2163.II.A.I. (8th ed., rev. 2 2004), it does not appear possible that the invention could include mechanical means for selectively locking the rear sole relative to the rear sole support and shoe upper, while also including a rear sole that is permanently fixed into position relative to the rear sole support and shoe upper. This latter embodiment would require that no mechanical means be present to allow a user to selectively lock the rear sole in position. Either the user can choose the position of the rear sole, or she cannot.

In *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, the Federal Circuit reviewed the construction of a patent in which the written description used similar "all embodiments" language. 242 F.3d 1337 (Fed. Cir. 2001). The court explained that "where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent." *Id.* at 1341. This is true even if the claim language, on its own, "might be considered broad enough to encompass the feature in question." *Id.* The specification in *SciMed* identified its lumen structure as coaxial rather than dual, discussed the disadvantages of a dual structure used in prior art, and described the coaxial lumen structure as "the basic sleeve structure for *all embodiments of the present invention contemplated and disclosed herein*." *Id.* at 1343. The court found this language defined the invention in a manner that excluded the dual structure, and it held it to be "a clear case of disclaimer of subject matter." *Id.* at 1344. The written description could not be discussing only a preferred embodiment because the defined structure was expressly applicable to "all embodiments of the present invention," words the court found "broad and unequivocal." *Id.* Indeed, the court went on to say that it would be "difficult to imagine how the patents could have been clearer" in making a coaxial lumen structure "a necessary element of every variant of the claimed invention." *Id.*

The potential reach of the *SciMed* decision has been narrowed in subsequent cases. First, any such disclaimer of subject matter must be explicit, and the mere absence of reference to an embodiment does not exclude that embodiment from the scope of the invention. *Liebel-Flarsheim Co. v. Medrad. Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004). Explicit disclaimer was found in *SciMed* because the specification (1) discussed only one type of structure, (2)

characterized an alternative structure as inferior, and (3) concluded that the preferred structure was used in "all embodiments of the present invention contemplated and disclosed herein." *Id.* No such disclaimer could be found in *Liebel-Flarsheim*, where the patent simply failed to describe an embodiment using the alternative structure. *Id.* at 907. Second, the disclaimer must be direct and clear. For example, where a patent described the filter and cap in a water bottle filter assembly as being "associated," this did not require "tenacious physical engagement." *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1121 (Fed. Cir. 2004). It only required that they be joined in some way. The reasoning of *SciMed* did not apply because the language was "less direct, clear and defining than the phrase '[the] structure . . . is the basic . . . structure for all embodiments.'" *Id.* at 1122 (quoting *SciMed*, 242 F.3d at 1344); *see also Honeywell. Inc. v. Victor Co. of Japan Ltd.*, 298 F.3d 1317, 1326 (Fed. Cir. 2002) (holding there was no disclaimer of subject matter when the written description merely described one embodiment as preferable to another).

Despite the subsequent interpretations of *SciMed*, it appears to apply to the "all embodiments" statement appearing in Akeva's patent. Like in *SciMed* where the lumen could be in either coaxial or dual form, the securing of the rear sole here presents two possible forms: it may be permanently fixed in place or it may be movable (i.e., "locked into position") by the wearer of the shoe. These embodiments cannot exist simultaneously. The clear and unequivocal language in the written description that "all embodiments of the present invention" include a mechanical means for selectively locking the rear sole show an unmistakable choice of one form over the other, and an unqualified disclaimer of a permanently positioned rear sole from the subject matter of the invention.

The written description contains further evidence that the invention does not include a permanently positioned rear sole. The written description makes the statement: "The present invention includes a shoe or shoe kit which includes or can accept a plurality of rear soles [] having different characteristics and/or surface configurations, thereby providing a cross trainer shoe." '300 Patent, col. 6, 11. 33-36. This statement appears to mean that the rear sole must be removable or detachable from the shoe so that other rear soles can replace it. This disclaimer of permanent attachment is inconsistent with other statements in the specification that envision a rear sole that is rotatable but not detachable. This internal inconsistency in the specification is too equivocal to render it a disclaimer of permanently attached rear soles. *See Honeywell*, 298 F.3d at 1327 (stating that an internally inconsistent summary statement about the invention "was not well thought out" and so no conclusive weight could be attached to it, but finding support for a structure contemplated by the sentence's first portion). However, even these statements are consistent in supporting the idea that the rear sole can be moved into various positions, whether or not the rear sole can be detached from the shoe.

Like in *SciMed*, the '300 Patent's specification discusses only a rear sole that is movable. None of the language cited by Akeva refutes the notion that the rear sole must be movable. Akeva refers to the statement that the "flexible region . . . can be used with permanently attached rear soles." '300 Patent, col. 10, 11. 14-16. This statement excludes only the detachability feature, one which the court does not read into the claim term, and does not address the movability of the rear sole. Likewise, the remainder of Akeva's arguments

are addressed to the notion of detachability.[4] Akeva has cited no statement in the '300 Patent's specification, and the court has found none, that would contemplate a rear sole that is permanently locked into position.

Therefore, the '300 Patent's claim terms' reference to "a rear sole secured" is construed to mean "a rear sole selectively or permanently fastened, but not permanently fixed in position."

In the '471 Patent, Claim 1, from which all other claims depend, discloses "a shoe comprising . . . a rear sole *secured* below a portion of the upper." '471 Patent, col. 13, 11. 7-9. No further mention of detachability, rotatability, or moveability is made in the 32 claims of this patent.

The '471 Patent's specification, however, disclaims not only a permanently fixed rear sole, but a permanently attached rear sole. In the first paragraph of the specification, subtitled "Field of the Invention," the patentee states that the "present invention relates generally to multi-purpose athletic shoes and, more particularly, to athletic shoes with interchangeable/detachable rear soles." '471 Patent, col.1, 11. 13-15. Following this introduction is a discussion of the problems of prior art, which discusses the inability of other detachable rear sole designs (mostly designs regarding dress shoes) to solve various problems, and the obstacles involved in adapting conventional detachable heel designs to athletic shoes without compromising cushioning and other important properties. *See id.*, col. 1, 1. 18 - col. 2, 1. 31. The section titled "Summary of the Invention" gives a general

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[4] In its proposed findings submitted to the court shortly after the Markman hearing, Akeva proposed a construction of "secured" that defined it as "attached and encompasses permanent, rotatable, and removable attachment."

description of the invention by saying "[a] rear sole is detachably secured to the rear sole support." *Id.*, col. 3, 11. 14-15. Most importantly, the written description later provides that "in a radical departure from conventional shoes, the *shoe of the present invention incorporates a heel structure, including a detachable rear sole*, that significantly alleviates heel wear problems associated with conventional soles and provides enhanced cushioning and/or spring." *Id.*, col. 4, 11. 54-59 (emphasis added).

Like in *SciMed*, Akeva's '471 Patent discusses only a detachable rear sole. The '471 Patent also characterizes the lack of detachable rear soles in conventional shoe designs as inferior. In addition to the statements above, a section on related art laments that "the unmistakable commercial trend appears to be increased specialization, with no apparent industry-awareness of the fact that the use and function of an athletic shoe can be changed dramatically if it is simply given interchangeable rear soles."[5] *Id.*, col. 2, 11. 50-54. Finally, the '471 Patent's written description contains a clear and unequivocal statement limiting the "shoe of the present invention" to designs incorporating "a heel structure[] including a detachable rear sole." Although this language is not the same as the "all embodiments" language of *SciMed* or the '300 Patent, the reference to "the shoe of the present invention" is a clear reference to the scope of the entire invention, and not merely to one or more embodiments. The use of "including a detachable rear sole" to modify the heel structure of the invention requires that all heel structures of

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[5] The discussion of prior art continues: "Similarly, no athletic shoe manufacturer has yet to offer varying heel cushioning firmness in each shoe size, despite the fact that consumer body weight for each shoe size spans a huge spectrum." '471 Patent, col. 2, 11. 54-57.

this invention include a detachable rear sole. *See C.R. Bard. Inc. v. United States Surgical Corp.*, 388 F.3d 858, 865 (Fed. Cir. 2004) (finding that the phrases "the implant includes a pleated surface" and a "plug having a pleated surface" meant the "patent required the 'implant' or 'plug' to have a pleated surface").

Thus, the '471 Patent's use of "secured" in Claim 1 in describing the connection of the rear sole to the shoe must be construed to mean "a rear sole detachably secured below a portion of the upper."

2. "Flexible plate"

According to Akeva, the "flexible plate" in the '300 patent should be defined according to its plain and ordinary meaning of "a smooth, thin piece of material that is bendable but which does not deform permanently when bent." adidas argues that the plain and ordinary meaning is rebutted because the term is "coined" by the patentee. The specification uses the terms "flexible" and "plate" in a manner inconsistent with their ordinary meanings. The plain and ordinary meaning of "flexible," adidas argues, is "capable of being bowed [i.e., bent down] without breaking" and the plain and ordinary meaning of "plate" is a piece of material that is flat, relatively thin, smooth and of uniform thickness, (adidas' Markman Br. at 12-13.) However, in the specification, a "plate" is not flat, smooth, or of uniform thickness, and "flexible" requires a convex or arched shape. To stay true to the patent, adidas argues, the flexible plate should be defined as "a separate and removable piece of material that is capable of being repeatedly bent from a normal, unflexed state (in which its central portion is elevated relative to its periphery) into a flexed state (in which the central portion is bent downward), without deforming permanently." (*Id.* at 12-13.)

adidas cites the following statement in support of its argument that the flexible plate must be elevated in the interior: "In each of the embodiments the central portion of the flexible member is raised relative to its outer perimeter so that when placed in the shoe, the interior portion in its normal state does not touch the rear sole support and/or rear sole." '300 Patent, col. 12, 11. 34-41. This statement does not support any limitation on the term "flexible plate." The structure with an elevated center is carefully set out as one possible embodiment of the flexible plate. The first phrase of the sentence, "in each of the embodiments," appears to refer to the embodiments described in the preceding sentence. That sentence begins "in each of the above described embodiments, ..." The "embodiments" in these sentences are not meant to encompass all possible embodiments of the invention, but only the ones the patentee has chosen to describe in the specification. In any case, to find any limitation in the structure of the flexible plate, the court would require a more direct and clear reference, along the lines of the "all embodiments" language used in *SciMed*, or a more explicit definition of the "flexible plate."

adidas argues, also, that the plate need not have a uniform thickness because the specification discloses an embodiment that is thicker at the center than at the periphery. *See* '300 Patent, col. 11, 11. 27-32. The description of one embodiment that does not fit within the technical definition of "plate" is not enough of an inconsistency to limit the claim. The word "plate" is not being used here in a highly technical or scientific way, but instead is a description of the shape of the component. Additionally, there is no indication that the plate must be thicker at the center than at the periphery, only that it may be so constructed.

Finally, adidas argues that a "flexible plate" cannot be integral with the shoe and must be construed as a separate and removable component. adidas contends that the written description refers mostly to a flexible region, which can take several forms, but the flexible plate is an embodiment of the flexible region that cannot be integral with other parts of the shoe. For example, the written description provides that "flexible region 200 can be incorporated into other elements of the shoe or can be a separate flexible member or plate." '300 Patent, col. 7, 11. 63-64. In the court's view, however, the patent appears to use the terms interchangeably. For instance, in referring to components depicted in the figures, the written description refers to both "flexible region 200" and "flexible member 200," and also to "flexible member 500" and "flexible plate 500." Additionally, the specification states that "any of the above-described flexible members may be used as flexible region 700." *Id.*, col. 12, 11. 58-59. The written description also contemplates that the flexible members may be integral with other components. For example: "flexible member 200 could be . . . incorporated as an integral part [] of either the rear sole support or the rear sole," and "similar configurations of an integral flexible region are within the spirit of the invention." *Id.*, col. 9, 11. 41-45; *see also id.*, col. 10, 11. 28-30 ("the following disclosed embodiments of flexible members can be integrally incorporated into a portion of the shoe"). Even if the flexible plate is an embodiment of the flexible member or flexible region, both the "member" and "region" are envisioned as being integral with other parts of the shoe in at least some embodiments. *See, e.g., id.*, col. 12, 11. 46-47 ("each of the above-described flexible members may be made integral with the rear sole support"). Thus, the court cannot find that the flexible plate must be a separate and removable component.

Therefore, the term flexible plate should be defined according to its plain and ordinary meaning. The dictionary definition of "plate" as a noun defining a shape is "a smooth usu. nearly flat and relatively thin piece of metal or other material" or "a perfectly flat sheet of material of uniform thickness throughout." Webster's Third New Int'l Dictionary 1734 (1986). Because there is some difference between the two definitions, the court must look to the specification to discern the appropriate choice. Here, the specification discloses several embodiments that are neither perfectly flat nor of uniform thickness. This indicates that the first, more general, definition is the better choice. The dictionary definition of "flexible" is "capable of being flexed," or more specifically, "capable of being turned, bowed, or twisted without breaking." Webster's Third New Int'l Dictionary 869 (1986). Again, the specification indicates that the properties of flexibility, cushioning, and springiness are important to the flexible plate. However, there is no indication that the plate need be capable of being turned or twisted. Akeva's proposed definition uses "bendable," and is otherwise consistent with the dictionary definition.

Thus, the term "flexible plate" should be construed to mean "a smooth, usually nearly flat, and relatively thin piece of metal or other material that is bendable."

3. "Peripheral portions of the plate being restrained from movement relative to an interior portion of the plate in a *direction substantially perpendicular* to a major axis of the shoe"

This claim term has been referred to as "relative restraint," and it causes the deflection feature discussed

below.[6] Both parties agree that the first part of this claim term is properly defined according to its plain and ordinary meaning. Akeva proposes a construction for "restrained from movement relative to an interior portion of the plate" as "a plate portion is restrained from movement as compared to a portion that is closer to the center of the plate." (Akeva's Markman Br. at 13.) adidas proposes separate constructions of various components of this phrase: (1) "restrained" should mean "prevented from doing something"; (2) "movement" should mean "change of place or position"; and (3) movement "relative to" should mean movement "of one body or point with respect to another body or point that is regarded as fixed." (adidas' Markman Br. at 14.) There is no substantive difference between the parties' definitions thus far. The parties also agree that "a major axis of the shoe" is the heel-to-toe axis.

The dispute centers on the phrase "in a direction substantially perpendicular." The crux of the disagreement is whether this includes the vertical direction. Akeva argues that this should be construed as "either the horizontal (medial-to-lateral) or vertical directions," while adidas argues it should be construed as only the "medial-to-lateral direction."[7] adidas contends that the term should be limited

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[6] The restraint and deflection terms are connected by the phrase "so that" and should be understood together to mean that the restraint feature functions in a certain manner "so that" the deflection can occur in a certain manner.

[7] In summary, Akeva proposes that this term, in its entirety, be construed to mean "a plate portion is restrained from movement as compared to a portion that is close to the center of the plate in either the horizontal (medial-to-lateral) or vertical directions." adidas proposes that the term mean "the peripheral portions of the flexible plate are prevented from changing their place or position

by the prosecution history because the patent examiner defined the term as the lateral-to-medial direction to distinguish it from a prior art reference and allow the claims.

The court must begin its construction with the plain and ordinary meaning. The dictionary definition of "perpendicular" used as an adjective in this context of a physical direction[8] "being or set at right angles to a given line or plane." Webster's Third New Int'l Dictionary 1684 (1986). adidas points out that the '300 Patent's specification discusses relative restraint only twice. The first statement teaches that "housing 580 acts as a reinforcement for limiting or eliminating lateral movement of the flexible member 560 during use." '300 Patent, col. 11, 11. 20-23. The second statement teaches that "each of the above-described flexible members may be made integral with the rear sole support, which . . . limits the lateral displacement of the periphery of the flexible member upon deflection." *Id.*, col. 12, 11. 47-52. These statements reference only lateral movement, but they do not redefine the restraint term nor do they disclaim or disavow any coverage of other types of movement of the flexible member. Thus, the specification contains no evidence to show the plain and ordinary meaning should be rebutted.

The only portion of the prosecution history before the court is the examiner's Notice of Allowability. In this notice, the examiner stated:

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in the medial to lateral direction with respect to an interior portion of the plate."

[8] The dictionary contains an additional definition of a physical direction related to the horizon and outdoor observation. This definition is inappropriate in the context of a patent over an athletic shoe where a given line is explicitly referenced.

> This language has been interpreted as the restrained direction being the direction perpendicular to the major axis, i.e.[,] the major axis is that axis which runs from the toe of the shoe to the heel of the shoe and *the direction perpendicular to such is the direction medial to lateral direction* and allows the interior portion of the plate to deflect relative to the peripheral portions in the perpendicular/vertical directions, i.e.[,] a direction perpendicular to the major axis.

(adidas' Markman Br. Ex. G. at 2 (emphasis added).) She continued that a prior art reference by Tong did not include this feature, and, in fact, the Tong shoe did not include any restraint of the peripheral portions in the medial-to-lateral direction. (*Id.* at 2-3.) Also, it provided "no guidance as to how the interior of the plate reacted in reference to the periphery of the plate." (*Id.*) The examiner concluded that the Tong reference must feature a plate that moved as a single element, functioned as "a supporting element, not a flexible deflective member," and did not feature any concave or convex sections on its upper surface. (*Id.* at 3.). She also described the Tong reference as having a wave shape that "allowed the plate to expand horizontally/in a direction along the major axis of the shoe, instead of vertically, i.e.[,] 'in a direction substantially perpendicular to a major axis of the shoe' as claimed [in the '300 Patent]." (*Id.*) For these reasons, the '300 Patent overcame the Tong reference.

The doctrine of prosecution history estoppel may limit a claim term where the prosecution history (or "file wrapper") shows the patentee made "express representations . . . to the examiner to induce a patent grant." *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985). "Such representations include amendments to the

claims and arguments made to convince the examiner that the claimed invention meets the statutory requirements of novelty, utility, and nonobviousness." *Id.* Statements like this would exclude from the definition of claim terms any subject matter that was "disclaimed or disavowed during prosecution in order to obtain claim allowance." *Id.* Estoppel also results when "arguments made during prosecution . . . show a clear and unmistakable surrender of subject matter." *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1251 (Fed. Cir. 2000) (internal quotations omitted). However, not all changes will result in estoppel. Changes are often made during a patent's prosecution, and "[a] non-substantive change or a change that did not in fact determine patentability does not create an estoppel." *Pall Corp. v. Micron Separations. Inc.*, 66 F.3d 1211, 1219 (Fed. Cir. 1995). If the examiner relies on a concession or argument to establish patentability over prior art, this "is a substantive position on the technology for which a patent is sought, and will generally generate an estoppel." *Id.* at 1220. On the other hand, "when claim changes or arguments are made in order to more particularly point out the applicant's invention, the purpose is to impart precision, not to overcome prior art." *Id.* In the latter case, no estoppel is presumed and the issue must be examined on its facts. *Id.*

In this case, it does not appear that estoppel is warranted because the examiner was clarifying an aspect of the invention without intending to limit it. She merely describes the features of the Akeva patent that distinguish it from the Tong reference. Whether or not the examiner was relying on an argument made by the patentee to overcome this prior art reference, there is no indication that she amended the claims to conform to a limited interpretation of the direction of relative restraint. Also, there was no need to limit the direction of relative restraint to only the medial-to-lateral

direction in order to establish patentability. If the Tong reference discloses an interior plate that does not feature any relative restraint, as the Notice of Allowability concludes, then the '300 Patent could disclose a plate wherein the periphery and interior moved separately in *any direction*, so long as separate movement was claimed. This would be enough to overcome the Tong reference. Moreover, if the examiner had excluded the vertical direction in regard to relative, restraint, this would create a problem for one of the allowed claims of the '300 Patent. Claim 192 includes a relative restraint feature wherein the plate portion is "restrained from movement in *a substantially vertical direction*." '300 Patent, col. 28, 11. 45-47 (emphasis added). Excluding the vertical direction would render this claim invalid.

Finally, the language of this notice is not clear enough to effect an estoppel. The first reference to the perpendicular direction discusses relative restraint and states "the direction perpendicular to such is the . . . medial to lateral direction." (adidas' Markman Br. Ex. G. at 2.) When the examiner discusses the deflection feature, however, she talks about the vertical direction. For instance, she concludes that the Tong reference's shape "allowed the plate to expand horizontally . . . , instead of *vertically, i.e. [,] 'in a direction substantially perpendicular* to a major axis of the shoe.'" (*Id.* at 3 (emphasis added).) Akeva argued at the Markman hearing that "*a* major axis of the shoe" is used in regard to the direction of relative restraint, while "*the* major axis of the shoe" is used in regard to the direction of deflection. This would mean that the latter comment about the vertical direction is made in reference to relative restraint, even though it appears to discuss deflection. Whether or not Akeva is correct about the examiner's reference, the court is unwilling to find estoppel based on this language.

Prosecution history estoppel is generally only found based on express statements or an unmistakable surrender of subject matter. Without a more direct statement by the examiner or the patentee regarding the meaning of this perpendicular direction, the court cannot find the scope of the term "perpendicular" in reference to the relative restraint term to be limited to the medial-to-lateral direction.

Thus, the term "peripheral portions of the plate being restrained from movement relative to an interior portion of the plate in a direction substantially perpendicular to a major axis of the shoe" should be construed as "the peripheral portions of the flexible plate are prevented from changing their place or position as compared to a portion that is close to the center of the plate in any direction that is substantially at a right angle to a heel-to-toe axis of the shoe, including the medial-to-lateral and vertical directions."[9]

4. "The interior portion of the plate is capable of being deflected relative to the peripheral portions in a *direction substantially perpendicular* to the major axis of the shoe"

This claim term is sometimes referred to as the "relative deflection" feature, and it occurs as a result of relative restraint, discussed above.[10] Akeva proposes the following

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[9] This definition does not include restraint in a direction along a heel-to-toe axis of the shoe, or parallel to such axis.

[10] Relative deflection is used in independent claims 93, 117, 118, 121, 122, and 204 and their dependencies. Claim 192 uses different language: "the interior portion of the plate is capable of being deflected relative to at least a portion of the restrained periphery *in a substantially vertical direction*." '300 Patent, col. 28, 11. 47-50 (emphasis added).

definition: "a plate portion can deflect as compared to a portion that is closer to the center of the plate, caused at least in part by the relative restraint." (Akeva's Markman Br. at 13.) adidas proposes that the term be construed as

> the interior portion of the plate is susceptible to undergoing an action wherein the position of the interior portion is changed through normal use from its normal unflexed state (in which the interior portion is elevated relative to the periphery of the plate) into a position in which the interior portion is bent downward with respect to the periphery of the plate.

(adidas' Proposed Cl. Construction Order at 2.) adidas' construction is based, in part, on the plain meaning of "capable" as "constituted, situated, or characterized as being susceptible or open to being affected"; the plain meaning of "deflected" as "curved or turned downward"; the plain meaning of "relative to" as "movement of one body with respect to another that is regarded as fixed." (adidas' Markman Br. at 17-18 (internal quotations omitted).)

adidas argues that "capable of being deflected" cannot take on its plain and ordinary meaning of "susceptible to changing its position to become curved or turned downward" because the specification discusses it in a very specific way. The plate is capable of changing position from a "normal, unflexed state" to a deflected position. The "normal, unflexed state" is one in which the plate's interior is elevated relative to the periphery, or is in a convex (domed) or arched position. This means, adidas contends, that the plate is convex and deflects to a position of concave. Otherwise, if the plate began in a concave shape, it could not be further deflected.

The plain and ordinary meaning of "deflected" as an adjective is "curved or turned downward." Webster's Third New Int'l Dictionary 592 (1986). The idea of "turning" an object would appear more appropriate in the context of the deflection of a projectile or moving object. "Curved" is more appropriate to a stationary object.

The court notes, first, that Akeva's definition is incorrect because the plain meaning of the term should require the center of the plate to deflect compared to the periphery. Plaintiff offers no evidence to refute this construction. adidas' argument that the plate must begin in a convex shape and deflect to a concave shape is also problematic. To begin with, a concave plate made of a flexible material (such as rubber) could be further deflected. More importantly, even if it is true that the specification discloses no other forms in discussing deflection, this would not be enough to warrant limiting the term unless there had also been a redefinition, disclaimer, or disavowal of claim scope with respect to this term. A specification need not discuss all possible embodiments of the invention, and simply because an embodiment is not discussed is not enough to exclude that embodiment from the scope of the invention. *See Liebel-Flarsheim*, 358 F.3d at 906 ("This court has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment."); *Alloc, Inc. v. ITC*, 342 F.3d 1361, 1370 (Fed. Cir. 2003) ("It is impermissible to read the one and only disclosed embodiment into a claim without other indicia that the patentee so intended to limit the invention."). A disclosure of only one embodiment may only be enough to limit the claim terms if the court can find that the patentee "demonstrated a clear intention to limit the claim scope using words or expressions of manifest exclusion or restriction." *Liebel-Flarsheim*, 358 F.3d at 906

(internal quotations omitted). Here, while it may be true that the specification only discusses a flexible plate that begins in a convex shape and deflects to a concave shape, the specification does not show any clear intent to limit the flexible plate to this shape.

The latter portion of this claim term "in a direction substantially perpendicular to the major axis of the shoe" specifies the direction of deflection. As an initial matter, and although the dictionary definition of "deflected" includes the direction "downward," the court will afford greater weight to the direction specified in the claim term itself. Next, the wording of this portion of the claim term is identical to the wording in the relative restraint term, except that the word "the" precedes "major axis" instead of the word "a." With regard to "in a direction substantially perpendicular," the court must construe this term the same way that it defined it regarding relative restraint. *See Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1345 (Fed. Cir. 1998) (noting the rule that "the same word appearing in the same claim should be interpreted consistently"). The parties are in agreement about the meaning of "the major axis of the shoe," as discussed above. Thus, the court must interpret this claim term according to its plain and ordinary meaning.

The relative deflection term will be construed as "the portions of the flexible plate close to the center are able to be curved, as compared to the peripheral portions of the flexible plate, in any direction that is substantially at a right angle to a heel-to-toe axis of the shoe, including the medial-to-lateral and vertical directions."

5. "The upper surface [of the flexible plate] having at least one *concave* portion"

The term at issue here is "concave," and the parties agree that the plain and ordinary meaning of "concave" is "hollowed or rounded inward like the inside of a bowl." They also agree that the plain and ordinary meaning of this term should apply. Akeva asserts, in addition, that this definition only applies when the surface is "viewed from the perspective where the surface is visible," which means that the upper surface of the plate must be viewed from above. The court sees no reason to deviate from the term's ordinary meaning. Neither the claims nor the specification contain any requirement regarding how the flexible plate should be viewed, and the court will not read additional requirements into the term. Akeva argues that adidas' expert views the flexible plate from below, but the court has not considered any expert testimony regarding claim construction. adidas makes note of the absence of any disclosure of a concave upper surface in the '300 Patent's specification, which discusses only convex or arched flexible regions or plates. The failure of the specification to discuss a particular embodiment is not enough to exclude that embodiment from the scope of the claims if the claims would otherwise encompass it. *See CCS Fitness*, 288 F.3d at 1368 ("[Defendant] cannot use the intrinsic evidence's silence to narrow the ordinary meaning of an unambiguous claim term.").

The term "concave" should be construed as "hollowed or rounded inward like the inside of a bowl."

6. "Opening"

adidas argues that the term "opening" must be construed according to its plain and ordinary meaning of "breach or

aperture" because the specification makes no mention of it. Akeva does not propose any claim construction for this term.

To the extent any dispute exists, the term "opening" should be defined as "breach or aperture."

7. "Curve"

Akeva proposes that this term take its plain and ordinary meaning of "a deviation from a straight line or plane surface without sharp breaks or angularity." adidas proposes no construction of its own.

To the extent any dispute exists, the term "curve" should be defined as "a deviation from a straight line or plane surface without sharp breaks or angularity."

D. The 6,662,471 Patent's Disputed Claim Terms

There is only one independent claim in the '471 Patent and 31 dependent claims. Akeva asserts that adidas infringes all of these claims. The first claim discloses the following invention (emphasis added to disputed terms):

1. A shoe comprising:

an upper, and

a rear sole *secured* below a portion of the upper, the rear sole comprising:

a member having a top wall with a lower surface, . . . the member having a bottom wall with an upper surface, . . . the top wall and the bottom wall each having a forward region and a rearward region, the forward regions of the top and bottom walls being connected at a closed end by a curved wall; . . . the rearward regions of the top and bottom walls being *oriented toward a back of the shoe*, . . .;

> at least one *element* positioned between at least a portion of the top wall and at least a portion of the bottom wall, the at least one element having at least one interior sidewall; . . . .

The term "secured" also appears in the '300 Patent and was discussed and defined in the discussion of "secured," above. These additional terms from the '471 Patent are disputed by the parties.

1. "The rearward regions of the top and bottom walls being *oriented toward a back of the shoe*"

adidas argues that the term "oriented toward a back of the shoe" should be construed as "placed at or near the side or surface of the shoe that is opposite the front (toe) of the shoe." It reaches this definition through the dictionary definitions of "back" ("the side or surface of something that is opposite to the side regarded as its front or face"), "orient" ("place in relation to"), and "toward" ("near" or "at a point in the direction of"). adidas claims that this is consistent with the specification's use of the term because in every disclosed embodiment, the rearward regions of the U-shaped member are placed at the back of the shoe. Akeva, in opposition, argues that the referenced rearward regions in the claim need not be physically located at or near the back of the shoe. Plaintiff proposes that the term's construction should stem from the plain and ordinary meaning of "oriented toward": "directed towards or placed in relation to a location at or near the back of the shoe."

The dictionary definition of "oriented" is "directed toward" or "placed in relation to." Webster's Third New Int'l Dictionary 1591 (1986). The definition of "toward" as a preposition is "in the direction of." Webster's Third New

Int'l Dictionary 2417 (1986). adidas has pointed to no compelling evidence suggesting that the plain and ordinary meaning should be rebutted or limited. The plain meaning of the phrase "oriented toward" does not include the requirement that an object that is "oriented toward" something must be placed physically near the thing. It encompasses only the notion that the object be facing a particular direction.

Therefore, the proper construction of "oriented toward a back of the shoe" should be construed as "directed toward or placed in the direction of a location at or near a back of the shoe."

2. "Element"

The parties agree that the ordinary meaning of "element" is "part" or "component" or, as Akeva proposes, "a constituent part." adidas, however, argues this broad definition cannot be used because it does not particularly point out and distinctly claim the subject matter of the invention, and applying ordinary meaning would cause the claim to fail the requirements of 35 U.S.C. § 112 ¶ 2. Because all shoes have parts or components, this would not be enough to let others know what specific kinds of parts were being claimed. adidas also argues that the specification uses the term "element" in a much narrower sense than simply a "part" of the shoe, and the term should be given this more narrow definition. In the written description, this part is described as a "stiffening member[]. . . that may be used to increase the spring generated by the rear sole." *See* '471 Patent, col. 11, 11. 54-57.

Generally, matters of "ambiguity, undue breadth, vagueness, and triviality are matters which go to claim validity for failure to comply with 35 U.S.C. § 112 ¶ 2, not

to interpretation or construction." *Intervet Am., Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989). However, it is a familiar axiom of patent law that when a claim term is ambiguous, it should be construed to sustain its validity. *Liebel-Flarsheim*, 358 F.3d at 911. This axiom does not apply "unless the court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous." *Id.* A court must look to the intrinsic evidence "to understand the claims *before* their breadth is limited for purposes of preserving validity." *Nazomi Comms., Inc. v. Arm Holdings PLC*, 403 F.3d 1364, 1368-69 (Fed. Cir. 2005) (emphasis added). "Otherwise the construing court has put the validity cart before the claim construction horse." *Id.* at 1369. In analyzing a claim of patent indefiniteness under 35 U.S.C., § 112 ¶ 2, "a court must determine whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1371 (Fed. Cir. 2004). If a claim term's meaning is discernible, then it is not invalid for indefiniteness. *Id.* Even if a claim is determined to be ambiguous, the court may only construe the claim and may not rewrite it to preserve validity. *Liebel-Flarsheim*, 358 F.3d at 911. A court also may not add limitations from the specification that do not appear in the claim. I, 887 F.2d at 1053.

Although it must be presumed that a claim is valid, 35 U.S.C. § 282, if a claim term is ambiguous, the court may choose the interpretation that preserves validity. A claim term is ambiguous if it is susceptible to more than one interpretation. In Claim 1 of the '471 Patent, the claim term "element" is followed by additional requirements of the object's location between the top and bottom walls and its structure that includes an interior sidewall. While the term is

quite broad, it is not ambiguous because it is susceptible to one interpretation – that of a component or part of the shoe that possesses the additional characteristics listed in the claim. adidas may be correct that this claim term is not sufficiently described to give one skilled in the art a clear idea of what the inventor intended, but it gives enough information to render the term unambiguous, and thus not amenable to added limitations. Any further issues of validity cannot be addressed at this time.

With regard to adidas' second argument, the descriptions in the specification cannot be used to limit this claim term. The language adidas references is an embodiment of the invention that appears to be intended as an example and not as any limitation on the claim's scope.

Therefore, the term "element" should be given its plain and ordinary meaning of "a constituent part."

In conclusion, with the exception of the term "secured" used in both the '300 Patent and the '471 Patent, the disputed terms should be construed according to their plain and ordinary meaning as discussed herein.

III. CONCLUSION

For the reasons set forth above,

IT IS ORDERED that the meaning and scope of the patent claims asserted to be infringed and presented by the parties for construction are determined as set forth in the foregoing Memorandum Opinion.

This the 17th day of May 2005.

William L. Osteen, United States District Judge

Appendix D

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

06-1090

AKEVA L.L.C.,
Plaintiff-Appellant,

v.

ADIDAS-SALOMON AG,
Defendant,

and

ADIDAS AMERICA, INC.,
Defendant-Appellee.

NOTE: This order is nonprecedential.

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the Appellant, and the petition for rehearing, having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on January 19, 2007.

FOR THE COURT,

Jan Horbaly, Clerk

Dated: 01/12/2007

cc: David F. Meschan

Douglas J. Kline

AKEVA V ADIDAS-SALOMON AG, 2006-1090
(DCT – 1:03-CV-01207)

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
JAN 12 2007
JAN HORBALY
CLERK